No.

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1992

SAMSUNG ELECTRONICS AMERICA, INC.,
a New York corporation, and
DAVID DEUTSCH ASSOCIATES, INC.,
a New York corporation,
Petitioners,

VS.

VANNA WHITE,
Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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QUESTIONS PRESENTED

1. Should a parody be stripped of its First Amendment protection merely because it appears in a commercial advertisement?

2. Even assuming that a parody appearing in a commercial advertisement may be treated as commercial speech, is the ruling below that summarily rejects any First Amendment defense for "garden-variety commercial speech" contrary to this Court's holding that commercial speech is protected if it meets the four-part test in *Central Hudson Gas & Elec. v. Public Serv. Comm'n*, 447 U.S. 557 (1980)?[1]

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[1] The parties below are named in the title of this petition. Petitioner David Deutsch Associates, Inc., now known as Deutsch/Dworin Inc., has no parent or subsidiary companies. The parent company of petitioner Samsung Electronics America, Inc., is Samsung Electronics Co., Ltd.

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Petition for a Writ Of Certiorari to the United States Court of Appeals for the Ninth Circuit

OPINIONS BELOW

The majority and dissenting opinions and judgment of the Court of Appeals for the Ninth Circuit, as amended on August 19, 1992, are printed in Appendix A. The order and the dissenting opinion on denial of rehearing *en banc* are printed in Appendix B. The opinions of the district court are printed in Appendix C and Appendix D.

JURISDICTION

The opinions and judgment of the Court of Appeals for the Ninth Circuit were initially filed and entered on July 29, 1992 and amended on August 19, 1992 (Appx. A), and its order denying rehearing was filed and entered on March 18, 1993 (Appx. B). This Court has jurisdiction pursuant to section 1254(1) of Title 28 of the United States Code.

CONSTITUTIONAL PROVISION INVOLVED

First Amendment, United States Constitution:

> "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances."

STATEMENT OF THE CASE

The majority opinion of the Court of Appeals summarizes the pertinent facts[2] and district court proceedings:[3]

> "Plaintiff Vanna White is the hostess of 'Wheel of Fortune,' one of the most popular game shows in television history. An estimated forty million people watch the program daily. Capitalizing on the fame which her participation in the show has bestowed on her, White markets her identity to various advertisers.
>
> "The dispute in this case arose out of a series of advertisements prepared for [petitioner Samsung Electronics America, Inc. ("Samsung")] by [petitioner David Deutsch Associates, Inc. ("Deutsch")]. The series ran in at least half a dozen publications with widespread, and in some cases national, circulation. Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By

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[2] Because the district court granted summary judgment in favor of defendants, the facts are here construed in plaintiff's favor. See Appx. A, p. 11.

[3] The jurisdiction of the district court was invoked under 28 U.S.C. § 1338 (action arising under any Act relating to trademarks) and 28 U.S.C. § 1332 because of diversity of citizenship, the plaintiff being a citizen of California and the defendants being New York corporations with their principal places of business outside of California.

> hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by depicting a raw steak with the caption: 'Revealed to be health food. 2010 A.D.' Another depicted irreverent 'news'-show host Morton Downey Jr., in front of an American flag with the caption: 'Presidential candidate. 2008 A.D.'
>
> "The advertisement which prompted the current dispute was for Samsung video-cassette recorders (VCRs). The ad depicted a robot, dressed in a wig, gown and jewelry which Deutsch consciously selected to resemble White's hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: 'Longest-running game show. 2012 A.D.' Defendants referred to the ad as the 'Vanna White' ad. Unlike the other celebrities used in the campaign, White neither consented to the ads nor was she paid.
>
> "Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under: (1) California Civil Code § 3344; (2) the California common law right of publicity; and (3) § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). The district court granted summary judgment against White on each of her claims. . . . "

Appx. A, pp. 2-3.

Vanna White appealed to the Court of Appeals for the Ninth Circuit, which had jurisdiction pursuant to 28 U.S.C. § 1291. The Court of Appeals affirmed in part, reversed in part and remanded: (1) The Court of Appeals' majority opinion affirmed the district court's dismissal of Vanna White's claim under California Civil Code § 3344. (2) The Court of Appeals' majority opinion reversed and remanded the district court's summary judgment in favor of defendants' on Vanna White's claims under the California common law right of publicity. In so holding, the Court of Appeals' majority opinion rejected defendants' argument that their advertisement was a parody that constituted protected speech. Appx. A. The Court of Appeals' majority opinion charac-

terized the parody as "garden-variety commercial speech" (Appx. A, p. 12, n.3) and reasoned that:

> "This case involves a true advertisement run for the purpose of selling Samsung VCRs. The ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: 'buy Samsung VCRs.' Defendants' parody arguments are better addressed to non-commercial parodies."

Appx. A., p. 11 (footnote omitted). Judge Alarcon concurred in the majority's affirmance of the district court's dismissal of Vanna White's claim under California Civil Code § 3344, but dissented from the majority's holdings on the right to publicity, Lanham Act and defendants' First Amendment defense. Appx. A, p. 12 (Alarcon, J., dissenting).

On March 18, 1993, the Court of Appeals denied a petition for rehearing. Appx. B. Judges Kozinski, O'Scannlain and Kleinfeld dissented from the Court of Appeals' order rejecting the suggestion for rehearing *en banc*. Appx. B.

REASONS FOR GRANTING CERTIORARI

This case has broad impact beyond the specific context of the advertisement at issue, a parody "intended to depict a robot, playing the role Vanna White currently plays on the Wheel of Fortune." Appx. A, p. 19 (Alarcon, J., dissenting). The decision is of crucial importance to all businesses that advertise in newspapers, magazines and the electronic media. The ruling below—that a parody should be stripped of its First Amendment protection merely because it appears in a commercial advertisement—in effect has declared that all commercial advertising should be treated as "garden-variety commercial speech" (Appx. A, p. 12, n.3), regardless whether the content is parody, political, or other constitutionally protected speech.

The crux of the ruling below is the Court of Appeal's erroneous view that "commercial speech" should be broadly defined. The underlying issue thus presented is not only whether a parody in a commercial advertisement is "commercial speech," but also what

this Court defines as "commercial speech" or " 'core' commercial speech" entitled to less protection than other constitutionally protected speech. This Court's recent opinion in *City of Cincinnati v. Discovery Network, Inc.*, ____ U.S. ____ , 61 U.S. Law Week 4272 (Mar. 24, 1993), identifies, but leaves unresolved, this critical issue of First Amendment doctrine.

As a practical matter, advertisers will simply avoid all controversial materials if their commercial advertisements will be treated as "garden-variety commercial speech" by the courts (Appx. A, p. 12, n.3), regardless of actual content. The chilling effect of such a precedent upon the First Amendment rights of businesses is indisputable. It is essential that this Court clarify the definition of "commercial speech" and resolve the question whether parody in a commercial advertisement is fully protected by the First Amendment.

I

A PARODY SHOULD NOT BE STRIPPED OF ITS FIRST AMENDMENT PROTECTION MERELY BECAUSE IT APPEARS IN A COMMERCIAL ADVERTISEMENT

The advertisement at issue in this case is undeniably a parody, "intended to depict a robot, playing the role Vanna White currently plays on the Wheel of Fortune." Appx. A, p. 19 (Alarcon, J., dissenting); *see* Appx. A, p. 2. Nevertheless, the Court of Appeals' majority opinion treats the advertisement as "garden-variety commercial speech" (Appx. A, p. 12, n.3), dismissing as irrelevant the advertisement's parody of Vanna White.

The critical issue is whether a parody should be stripped of its First Amendment protection merely because it appears in a commercial advertisement. This Court's decision in *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988), establishes that a parody is immune from sanction in the form of damages, unless a plaintiff shows a false statement of fact made with "actual malice." 485 U.S. at 56. The majority opinion, however, strips the Vanna White parody of its First Amendment protection merely because it appears in a commercial advertisement. According to the majority opinion,

> "In the case of commercial advertising, however, the first amendment hurdle is not so high. *Central Hudson Gas & Electric Corp. v. Public Service Comm'n*, 447 U.S. 557, 566 (1980). Realizing this, Samsung attempts to elevate its ad above the status of garden-variety commercial speech by pointing to the ad's parody of Vanna White. Samsung's argument is unavailing. *See Board of Trustees, State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474-75 (1989); *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 67-68 (1983)."

Appx. A, p. 12, n.3. The majority opinion's reliance upon *Bolger* and *Fox* is misplaced. This Court's recent opinion (issued after denial of rehearing *en banc* in the instant case) in *City of Cincinnati v. Discovery Network, Inc.*, ___ U.S. ___, 61 U.S. Law Week 4272 (Mar. 24, 1993), demonstrates that the majority opinion misreads *Bolger* and *Fox* in characterizing the parody as "garden-variety commercial speech."

In *City of Cincinnati*, this Court noted that *Central Hudson Gas & Elec. Corp. v. Public Service Comm'n*, 447 U.S. 557 (1980), had originally suggested a broad definition of commercial speech entitled to lesser protection than other constitutionally guaranteed speech—"expression related solely to the economic interests of the speaker and its audience." *City of Cincinnati, supra*, ___ U.S. ___, 61 U.S. Law Week at 4275; quoting *Central Hudson, supra*, 447 U.S. at 561. This Court explained in *City of Cincinnati*, however, that this definition was *not* later used in *Bolger* or *Fox*:

> "It is noteworthy that in reaching that conclusion [in *Bolger*] we did not simply apply the broader definition of commercial speech advanced in *Central Hudson* . . . but rather 'examined [them] carefully to ensure that speech deserving of greater constitutional protection is not inadvertently suppressed.' 463 U.S., at 66. In *Fox*, we described the category even more narrowly, by characterizing the proposal of a commercial transaction as '*the test* for identifying commercial speech.' 492 U.S., at 473-474 (emphasis added)."

City of Cincinnati, supra, ___ U.S. ___, 61 U.S. Law Week at 4275 (footnote omitted). Under either the *Bolger* or *Fox* test

described in *Central Hudson*, the Vanna White parody deserves full constitutional protection. The Vanna White parody does not propose a commercial transaction, and examining the content of the parody reveals that it is precisely the type of constitutionally protected speech that should not be inadvertently suppressed by an overly broad definition of "commercial speech."

In *City of Cincinnati*, this Court found the restrictions at issue in that case violated the First Amendment, even assuming that the speech being restricted there was " 'core' commercial speech." ___ U.S. ___, 61 U.S. Law Week at 4275. Thus, this Court's opinion in *City of Cincinnati* still leaves unresolved the precise test for determining what (if anything) is "commercial speech" or " 'core' commercial speech" entitled to lesser protection than other constitutionally protected speech, such as the Vanna White parody here. This issue is of crucial importance to modern-day First Amendment doctrine. As noted by Judge Kozinski's opinion dissenting to the denial of rehearing *en banc*:

> "In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared. Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a celebrity's identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add something, perhaps something worthwhile and memorable, perhaps not, to our culture. Both are things that the people being portrayed might dearly want to suppress. . . ."

Appx. B, p. 41 (Kozinski, J., dissenting from denial of rehearing *en banc*).

Clearly the issues presented are of crucial importance to all businesses in the country who advertise, and to the future course of First Amendment doctrine as well.

II

IN ANY EVENT, THE RULING BELOW THAT SUMMARILY REJECTS ANY FIRST AMENDMENT DEFENSE OF "GARDEN-VARIETY COMMERCIAL SPEECH" IS CONTRARY TO THE DECISION OF THIS COURT IN *CENTRAL HUDSON GAS & ELEC. V. PUBLIC SERV. COMM'N*, 447 U.S. 557 (1980)

Even assuming that a parody appearing in a commercial advertisement may be treated as commercial speech, the ruling below nonetheless errs in summarily rejecting any First Amendment defense of what the majority opinion characterized as "garden-variety commercial speech."

In *Central Hudson Gas & Elec. v. Public Serv. Comm'n*, 447 U.S. 557 (1980), this Court set forth a four-part test in commercial speech cases:

> "In commercial speech cases, then, a four-part analysis has developed. At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest."

447 U.S. at 566.

As pointed out by Judge Kozinski's opinion dissenting to the denial of rehearing *en banc*, the majority opinion summarily rejects any First Amendment defense, contrary to *Central Hudson's* four-part test:

> "The panel majority doesn't even purport to apply the *Central Hudson* test, which the Supreme Court devised specifically for determining whether a commercial speech restriction is valid. The majority doesn't ask, as *Central Hudson* requires, whether the speech restriction is justified by a substantial state interest. It doesn't ask whether the

> restriction directly advances the interest. It doesn't ask whether the restriction is narrowly tailored to the interest. . . . These are all things the Supreme Court told us—in no uncertain terms—we must consider; the majority opinion doesn't even mention them.
>
> ". . . [The Supreme Court] devised the test because it saw lower courts were giving the First Amendment short shrift when confronted with commercial speech. . . . The *Central Hudson* test was an attempt to constrain lower courts' discretion, to focus judges' thinking on the important issues—how strong the state interest is, how broad the regulation is, whether a narrower regulation would work just as well."[4]

Appx. B, pp. 41-42 (Kozinski, J., dissenting from denial of rehearing *en banc*) (footnotes omitted).

The Court of Appeals has created a dangerous precedent by summarily rejecting any First Amendment defense without applying the *Central Hudson* test. The ruling below allows the lower courts to impose liability on protected speech merely by characterizing it as "garden-variety commercial speech"; its precedential effect will necessarily "chill" both commercial and non-commercial speech. Under the ruling below, once a court characterizes speech as "commercial," the protections of the First

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[4] Judge Kozinski added:

> "The government has a freer hand in regulating false or misleading commercial speech, but this isn't such a regulation. Some 'appropriations' of a person's 'identity' might misleadingly suggest an endorsement, but the mere possibility that speech might mislead isn't enough to strip it of First Amendment protection."

Appx. B, p. 42, n.34 (Kozinski, J., dissenting to denial of rehearing *en banc*). Indeed, the majority opinion's analysis of Vanna White's claims makes clear that it was not requiring falsity. On Vanna White's Lanham Act claim, the majority opinion required only a showing of "likelihood of confusion." Appx. A, p. 8. And, on Vanna White's California common law right of publicity claim, the majority opinion required only a showing of appropriation of the plaintiff's identity, regardless of whether or not the advertisement is actually misleading. See Appx. A, pp. 5-6.

Amendment simply disappear, with no analysis of state interest, nexus to that interest, or whether the regulation is narrowly tailored. Thus, the ruling below, if left unreviewed, will have a devastating impact upon advertisers and, indeed, all businesses.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

Respectfully submitted,
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APPENDIX A

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

VANNA WHITE,
Plaintiff-Appellant,

v.

SAMSUNG ELECTRONICS AMERICA, INC.,
a New York corporation, and
DAVID DEUTSCH ASSOCIATES, INC.,
a New York corporation,
Defendants-Appellees.

No. 90-55840

D.C. No. CV-88-06499-RSWL

ORDER AND AMENDED OPINION

Appeal from the United States District Court
for the Central District of California
Ronald S.W. Lew, District Judge, Presiding

Argued and Submitted
June 7, 1991—Pasadena, California

Filed July 29, 1992
Amended August 19, 1992

Before: Alfred T. Goodwin, Harry Pregerson, and
Arthur L. Alarcon, Circuit Judges.

Opinion by Judge Goodwin; Partial Concurrence,
Partial Dissent by Judge Alarcon

OPINION

This case involves a promotional "fame and fortune" dispute. In running a particular advertisement without Vanna White's permission, defendants Samsung Electronics America, Inc. (Samsung) and David Deutsch Associates, Inc. (Deutsch) at-

tempted to capitalize on White's fame to enhance their fortune. White sued, alleging infringement of various intellectual property rights, but the district court granted summary judgment in favor of the defendants. We affirm in part, reverse in part, and remand.

Plaintiff Vanna White is the hostess of "Wheel of Fortune," one of the most popular game shows in television history. An estimated forty million people watch the program daily. Capitalizing on the fame which her participation in the show has bestowed on her, White markets her identity to various advertisers.

The dispute in this case arose out of a series of advertisements prepared for Samsung by Deutsch. The series ran in at least half a dozen publications with widespread, and in some cases national, circulation. Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects. For example, one lampooned current popular notions of an unhealthy diet by depicting a raw steak with the caption: "Revealed to be health food. 2010 A.D." Another depicted irreverent "news"-show host Morton Downey Jr. in front of an American flag with the caption: "Presidential candidate. 2008 A.D."

The advertisement which prompted the current dispute was for Samsung video-cassette recorders (VCRs). The ad depicted a robot, dressed in a wig, gown, and jewelry which Deutsch consciously selected to resemble White's hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: "Longest-running game show. 2012 A.D." Defendants referred to the ad as the "Vanna White" ad. Unlike the other celebrities used in the campaign, White neither consented to the ads nor was she paid.

Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under: (1) California Civil Code § 3344; (2) the California common law right of publicity;

and (3) § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). The district court granted summary judgment against White on each of her claims. White now appeals.

I. *Section 3344.*

White first argues that the district court erred in rejecting her claim under section 3344. Section 3344(a) provides, in pertinent part, that "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, . . . for purposes of advertising or selling, . . without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof."

White argues that the Samsung advertisement used her "likeness" in contravention of section 3344. In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), this court rejected Bette Midler's section 3344 claim concerning a Ford television commercial in which a Midler "sound-alike" sang a song which Midler had made famous. In rejecting Midler's claim, this court noted that "[t]he defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was [another person's], not hers. The term 'likeness' refers to a visual image not a vocal imitation." *Id.* at 463.

In this case, Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White's precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a "likeness," we agree with the district court that the robot at issue here was not White's "likeness" within the meaning of section 3344. Accordingly, we affirm the court's dismissal of White's section 3344 claim.

II. *Right of Publicity.*

White next argues that the district court erred in granting summary judgment to defendants on White's common law right of publicity claim. In *Eastwood v. Superior Court*, 149 Cal.App.3d 409 (1983), the California court of appeal stated that the common law right of publicity cause of action "may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury." *Id.* at 417 (citing Prosser, Law of Torts (4th ed. 1971) § 117, pp. 804-807). The district court dismissed White's claim for failure to satisfy *Eastwood*'s second prong, reasoning that defendants had not appropriated White's "name or likeness" with their robot ad. We agree that the robot ad did not make use of White's name or likeness. However, the common law right of publicity is not so confined.

The *Eastwood* court did not hold that the right of publicity cause of action could be pleaded only by alleging an appropriation of name or likeness. *Eastwood* involved an unauthorized use of photographs of Clint Eastwood and of his name. Accordingly, the *Eastwood* court had no occasion to consider the extent beyond the use of name or likeness to which the right of publicity reaches. That court held only that the right of publicity cause of action "may be" pleaded by alleging, *inter alia*, appropriation of name or likeness, not that the action may be pleaded *only* in those terms.

The "name or likeness" formulation referred to in *Eastwood* originated not as an element of the right of publicity cause of action, but as a description of the types of cases in which the cause of action had been recognized. The source of this formulation is Prosser, *Privacy*, 48 Cal.L.Rev. 383, 401-07 (1960), one of the earliest and most enduring articulations of the common law right of publicity cause of action. In looking at the case law to that point, Prosser recognized that right of publicity cases involved one of two basic factual scenarios: name appropriation, and picture or other likeness appropriation. *Id.* at 401-02, nn.156-57.

Even though Prosser focused on appropriations of name or likeness in discussing the right of publicity, he noted that "[i]t is

not impossible that there might be appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy." *Id.* at 401, n.155.[1] At the time Prosser wrote, he noted however, that "no such case appears to have arisen." *Id.*

Since Prosser's early formulation, the case law has borne out his insight that the right of publicity is not limited to the appropriation of name or likeness. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), the defendant had used a photograph of the plaintiff's race car in a television commercial. Although the plaintiff appeared driving the car in the photograph, his features were not visible. Even though the defendant had not appropriated the plaintiff's name or likeness, this court held that plaintiff's California right of publicity claim should reach the jury.

In *Midler,* this court held that, even though the defendants had not used Midler's name or likeness, Midler had stated a claim for violation of her California common law right of publicity because "the defendants . . . for their own profit in selling their product did appropriate part of her identity" by using a Midler sound-alike. *Id.* at 463-64.

In *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), the defendant had marketed portable toilets under the brand name "Here's Johnny"—Johnny Carson's signature "Tonight Show" introduction—without Carson's permission. The district court had dismissed Carson's Michigan common law right of publicity claim because the defendants had not used Carson's "name or likeness." *Id.* at 835. In reversing the district court, the sixth circuit found "the district court's conception of the right of publicity . . . too narrow" and held that the right was implicated because the defendant had appropriated Carson's identity by using, *inter alia*, the phrase "Here's Johnny." *Id.* at 835-37.

These cases teach not only that the common law right of

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[1] Under Professor Prosser's scheme, the right of publicity is the last of the four categories of the right to privacy. Prosser, 48 Cal.L.Rev. at 389.

publicity reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity. The right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable. It is noteworthy that the *Midler* and *Carson* defendants not only avoided using the plaintiff's name or likeness, but they also avoided appropriating the celebrity's voice, signature, and photograph. The photograph in *Motschenbacher* did include the plaintiff, but because the plaintiff was not visible the driver could have been an actor or dummy and the analysis in the case would have been the same.

Although the defendants in these cases avoided the most obvious means of appropriating the plaintiffs' identities, each of their actions directly implicated the commercial interests which the right of publicity is designed to protect. As the *Carson* court explained:

> [t]he right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. . . . If the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his "name or likeness" is used.

Carson, 698 F.2d at 835. It is not important *how* the defendant has appropriated the plaintiff's identity, but *whether* the defendant has done so. *Motschenbacher, Midler*, and *Carson* teach the impossibility of treating the right of publicity as guarding only against a laundry list of specific means of appropriating identity. A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.

Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. The right would fail to

protect those plaintiffs most in need of its protection. Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black high-top Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.

Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one. Indeed, defendants themselves referred to their ad as the "Vanna White" ad. We are not surprised.

Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the

celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof. We decline Samsung and Deutch's invitation to permit the evisceration of the common law right of publicity through means as facile as those in this case. Because White has alleged facts showing that Samsung and Deutsch had appropriated her identity, the district court erred by rejecting, on summary judgment, White's common law right of publicity claim.

III. *The Lanham Act*

White's final argument is that the district court erred in denying her claim under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). The version of section 43(a) applicable to this case[2] provides, in pertinent part, that "[a]ny person who shall . . . use, in connection with any goods or services . . . any false description or representation . . . shall be liable to a civil action . . . by any person who believes that he is or is likely to be damaged by the use of any such false description or designation." 15 U.S.C. § 1125(a).

To prevail on her Lanham Act claim, White is required to show that in running the robot ad, Samsung and Deutsch created a likelihood of confusion, *Academy of Motion Picture Arts v. Creative House*, 944 F.2d 1446, 1454 (9th Cir. 1991); *Toho Co. Ltd. v. Sears Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981) *New West Corp. v. NYM Co. of California*, 595 F.2d 1194, 1201 (9th Cir. 1979), over whether White was endorsing Samsung's VCRs. *HMH Publishing Co. v. Brincat*, 504 F.2d 713 (9th Cir. 1974); *Allen v. National Video, Inc.*, 610 F.Supp. 612 (D.C.N.Y. 1985).

This circuit recognizes several different multi-factor tests for determining whether a likelihood of confusion exists. *See Academy*, 944 F.2d at 1454, n.3. None of these tests is correct to the exclusion of the others. *Eclipse Associates Ltd. v. Data General Corp.*, 894 F.2d 1114, 1118 (9th Cir. 1990). Normally, in reviewing the district court's decision, this court will look to the particular test that the district court used. *Academy*, 944 F.2d at

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[2] The statute was amended after White filed her complaint. The amendments would not have altered the analysis in this case however.

1454, n.3; *Eclipse*, 894 F.2d at 1117-1118. However, because the district court in this case apparently did not use any of the multi-factor tests in making its likelihood of confusion determination, and because this case involves an appeal from summary judgment and we review de novo the district court's determination, we will look for guidance to the 8-factor test enunciated in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). According to *AMF*, factors relevant to a likelihood of confusion include:

(1) strength of the plaintiff's mark;

(2) relatedness of the goods;

(3) similarity of the marks;

(4) evidence of actual confusion;

(5) marketing channels used;

(6) likely degree of purchaser care;

(7) defendant's intent in selecting the mark;

(8) likelihood of expansion of the product lines.

599 F.2d at 348-49. We turn now to consider White's claim in light of each factor.

In cases involving confusion over endorsement by a celebrity plaintiff, "mark" means the celebrity's persona. *See Allen*, 610 F.Supp. at 627. The "strength" of the mark refers to the level of recognition the celebrity enjoys among members of society. *See Academy*, 944 F.2d at 1455. If Vanna White is unknown to the segment of the public at whom Samsung's robot ad was directed, then that segment could not be confused as to whether she was endorsing Samsung VCRs. Conversely, if White is well-known, this would allow the possibility of a likelihood of confusion. For the purposes of the *Sleekcraft* test, White's "mark," or celebrity identity, is strong.

In cases concerning confusion over celebrity endorsement, the plaintiff's "goods" concern the reasons for or source of the plaintiff's fame. Because White's fame is based on her televised performances, her "goods" are closely related to Samsung's VCRs. Indeed, the ad itself reinforced the relationship by inform-

ing its readers that they would be taping the "longest-running game show" on Samsung's VCRs well into the future.

The third factor, "similarity of the marks," both supports and contradicts a finding of likelihood of confusion. On the one hand, all of the aspects of the robot ad identify White; on the other, the figure is quite clearly a robot, not a human. This ambiguity means that we must look to the other factors for resolution.

The fourth factor does not favor White's claim because she has presented evidence of actual confusion.

Fifth, however, White has appeared in the same stance as the robot from the ad in numerous magazines, including the covers of some. Magazines were used as the marketing channels for the robot ad. This factor cuts toward a likelihood of confusion.

Sixth, consumers are not likely to be particularly careful in determining who endorses VCRs, making confusion as to their endorsement more likely.

Concerning the seventh factor, "defendant's intent," the district court found that, in running the robot ad, the defendants had intended a spoof of the "Wheel of Fortune." The relevant question is whether the defendants "intended to profit by confusing consumers" concerning the endorsement of Samsung VCRs. *Toho*, 645 F.2d 788 (9th Cir. 1981). We do not disagree that defendants intended to spoof Vanna White and "Wheel of Fortune." That does not preclude, however, the possibility that defendants also intended to confuse consumers regarding endorsement. The robot ad was one of a series of ads run by defendants which followed the same theme. Another ad in the series depicted Morton Downey Jr. as a presidential candidate in the year 2008. Doubtless, defendants intended to spoof presidential elections and Mr. Downey through this ad. Consumers, however, would likely believe, and would be correct in so believing, that Mr. Downey was paid for his permission and was endorsing Samsung products. Looking at the series of advertisements as a whole, a jury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers that celebrity Vanna White, like celebrity Downey, was endorsing Samsung products.

Finally, the eighth factor, "likelihood of expansion of the product lines," does not appear apposite to a celebrity endorsement case such as this.

Application of the *Sleekcraft* factors to this case indicates that the district court erred in rejecting White's Lanham Act claim at the summary judgment stage. In so concluding, we emphasize two facts, however. First, construing the motion papers in White's favor, as we must, we hold only that White has raised a genuine issue of material fact concerning a likelihood of confusion as to her endorsement. *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851, 852-53 (9th Cir. 1989). Whether White's Lanham Act claim should succeed is a matter for the jury. Second, we stress that we reach this conclusion in light of the peculiar facts of this case. In particular, we note that the robot ad identifies White and was part of a series of ads in which other celebrities participated and were paid for their endorsement of Samsung's products.

IV. *The Parody Defense*

In defense, defendants cite a number of cases for the proposition that their robot ad constituted protected speech. The only cases they cite which are even remotely relevant to this case are *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) and *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987). Those cases involved parodies of advertisements run for the purpose of poking fun at Jerry Falwell and L.L. Bean, respectively. This case involves a true advertisement run for the purpose of selling Samsung VCRs. The ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: "buy Samsung VCRs." Defendants' parody arguments are better addressed to non-commercial parodies.[3] The

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[3] In warning of a first amendment chill to expressive conduct, the dissent reads this decision too broadly. *See Dissent* at 9014. This case concerns only the market which exists in our society for the exploitation of celebrity to sell products, and an attempt to take a free ride on a celebrity's celebrity value. Commercial advertising which relies on celebrity fame is different from other forms of expressive activity in two crucial ways.

difference between a "parody" and a "knock-off" is the difference between fun and profit.

V. *Conclusion*

In remanding this case, we hold only that White has pleaded claims which can go to the jury for its decision. AFFIRMED IN PART, REVERSED IN PART, and REMANDED.

ALARCON, Circuit Judge, concurring in part, dissenting in part:

Vanna White seeks recovery from Samsung based on three theories: the right to privacy, the right to publicity, and the Lanham Act. I concur in the majority's conclusions on the right to privacy. I respectfully dissent from its holdings on the right to publicity and the Lanham Act claims.

I. *RIGHT TO PRIVACY (CAL. CIV. CODE § 3344(a))*

I agree with the majority's conclusion that no reasonable jury could find that the robot was a "likeness" of Vanna White within the meaning of California Civil Code section 3344(a).

First, for celebrity exploitation advertising to be effective, the advertisement must evoke the celebrity's identity. The more effective the evocation, the better the advertisement. If, as Samsung claims, its ad was based on a "generic" game-show hostess and not on Vanna White, the ad would not have violated anyone's right of publicity, but it would also not have been as humorous or as effective.

Second, even if some forms of expressive activity, such as parody, do rely on identity evocation, the first amendment hurdle will bar most right of publicity actions against those activities. *Cf. Falwell,* 485 U.S. at 46 (1988). In the case of commercial advertising, however, the first amendment hurdle is not so high. *Central Hudson Gas & Electric Corp. v. Public Service Comm'n of New York,* 447 U.S. 557, 566 (1980). Realizing this, Samsung attempts to elevate its ad above the status of garden-variety commercial speech by pointing to the ad's parody of Vanna White. Samsung's argument is unavailing. *See Board of Trustees, State Univ. of N.Y. v. Fox,* 492 U.S. 469, 474-75 (1988); *Bolger v. Youngs Drug Products Corp.,* 463 U.S. 60, 67-68 (1983). Unless the first amendment bars all right of publicity actions—and it does not, *see Zachini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562 (1977)—then it does not bar this case.

II. *RIGHT TO PUBLICITY*

I must dissent from the majority's holding on Vanna White's right to publicity claim. The district court found that, since the commercial advertisement did not show a "likeness" of Vanna White, Samsung did not improperly use the plaintiff's identity. The majority asserts that the use of a likeness is not required under California common law. According to the majority, recovery is authorized if there is an appropriation of one's "identity." I cannot find any holding of a California court that supports this conclusion. Furthermore, the record does not support the majority's finding that Vanna White's "identity" was appropriated.

The district court relied on *Eastwood v. Superior Court,* 149 Cal. App. 2d 409, 198 Cal. Rptr. 342, (1983), in holding that there was no cause of action for infringement on the right to publicity because there had been no use of a likeness. In *Eastwood,* the California Court of Appeal described the elements of the tort of "commercial appropriation of the right of publicity" as "(1) the defendant's use of the plaintiff's identity; (2) *the appropriation of plaintiff's name or likeness* to defendant's advantage, . . . ;(3) lack of consent; and (4) resulting injury." *Id.* at 417. (Emphasis added).

All of the California cases that my research has disclosed hold that a cause of action for appropriation of the right to publicity requires proof of the appropriation of a name or likeness. *See, e.g., Lugosi v. Universal Pictures,* 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979) ("The so-called right of publicity means in essence that the reaction of the public to name and likeness . . . endows the name and likeness of the person involved with commercially exploitable opportunities."); *Guglielmi v. Spelling-Goldberg Prods.,* 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352, 355 (1979) (use of name of Rudolph Valentino in fictional biography allowed); *Eastwood v. Superior Court, supra* (use of photo and name of actor on cover of tabloid newspaper); *In re Weingand,* 231 Cal. App. 2d 289; 41 Cal. Rptr. 778 (1964) (aspiring actor denied court approval to change name to "Peter Lorie" when famous actor Peter Lorre objected); *Fairfield v. American Photocopy Equip. Co.,* 138 Cal. App. 2d 82 (1955), *later app.* 158 Cal. App. 2d 53, 322 P.2d 93 (1958) (use of

attorney's name in advertisement); *Gill v. Curtis Publishing Co.*, 38 C.2d 273, 239 P. 630 (1952) (use of photograph of a couple in a magazine).

Notwithstanding the fact that California case law clearly limits the test of the right to publicity to name and likeness, the majority concludes that "the common law right of publicity is not so confined." Majority opinion at p. 9926. The majority relies on two factors to support its innovative extension of the California law. The first is that the *Eastwood* court's statement of the elements was permissive rather than exclusive. The second is that Dean Prosser, in describing the common law right to publicity, stated that it might be possible that the right extended beyond name or likeness. These are slender reeds to support a federal court's attempt to create new law for the state of California.

In reaching its surprising conclusion, the majority has ignored the fact that the California Court of Appeal in *Eastwood* specifically addressed the differences between the common law right to publicity and the statutory cause of action codified in California Civil Code section 3344. The court explained that "[t]he differences between the common law and the statutory actions are: (1) Section 3344, subdivision (a) requires *knowing* use whereas under case law, mistake and inadvertence are not a defense against commercial appropriation and (2) section 3344, subdivision (g) expressly provides that its remedies are cumulative and in addition to any provided by law." *Eastwood*, 149 Cal. App. 3d at n.6 (emphasis in original). The court did not include appropriations of identity by means other than name or likeness among its list of differences between the statute and the common law.

The majority also relies on Dean Prosser's statement that "[i]t is not impossible that there might be an appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy." Prosser, *Privacy*, 48 Cal.L.Rev. 383, 401 n.155 (1960). As Dean Prosser noted, however, "[n]o such case appears to have arisen." *Id.*

The majority states that the case law has borne out Dean Prosser's insight that the right to publicity is not limited to name

or likeness. As noted above, however, the courts of California have never found an infringement on the right to publicity without the use of the plaintiff's name or likeness.

The interest of the California Legislature as expressed in California Civil Code section 3344 appears to preclude the result reached by the majority. The original section 3344 protected only name or likeness. In 1984, ten years after our decision in *Motschenbacher v. R.J. Reynolds Tobacco Company,* 498 F.2d 821 (9th Cir. 1974) and 24 years after Prosser speculated about the future development of the law of the right of publicity, the California legislature amended the statute. California law now makes the use of someone's voice or signature, as well as name or likeness, actionable. Cal. Civ. Code sec. 2233(a) (Deering 1991 Supp.). Thus, California, after our decision in Motschenbacher specifically contemplated protection for interests other than name or likeness, but did not include a cause of action for appropriation of another person's identity. The ancient maxim, *inclusio unius est exclusio alterius,* would appear to bar the majority's innovative extension of the right of publicity. The clear implication from the fact that the California Legislature chose to add only voice and signature to the previously protected interests is that it wished to limit the cause of action to enumerated attributes.

The majority has focused on federal decisions in its novel extension of California Common Law. Those decisions do not provide support for the majority's decision.

In each of the federal cases relied upon by the majority, the advertisement affirmatively represented that the person depicted therein was the plaintiff. In this case, it is clear that a metal robot and not the plaintiff, Vanna White, is depicted in the commercial advertisement. The record does not show an appropriation of Vanna White's identity.

In *Motschenbacher,* a picture of a well-known race driver's car, including its unique markings, was used in an advertisement. *Id.* at 822. Although the driver could be seen in the car, his features were not visible. *Id.* The distinctive markings on the car were the only information shown in the ad regarding the identity of the driver. These distinctive markings compelled the inference that

Motschenbacher was the person sitting in the racing car. We concluded that "California appellate courts would . . . afford legal protection to an individual's proprietary interest in his own identity." *Id.* at 825. (Emphasis added). Because the distinctive markings on the racing car were sufficient to identify Motschenbacher as the driver of the car, we held that an issue of fact had been raised as to whether his identity had been appropriated. *Id.* at 827.

In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), a singer who had been instructed to sound as much like Bette Midler as possible, sang a song in a radio commercial made famous by Bette Midler. *Id.* at 461. A number of persons told Bette Midler that they thought that she had made the commercial. *Id.* at 462. Aside from the voice, there was no information in the commercial from which the singer could be identified. We noted that "[t]he human voice is one of the most palpable ways identity is manifested." *Id.* at 463. We held that, "[t]o impersonate her voice is to pirate her identity," *id.*, and concluded that Midler had raised a question of fact as to the misappropriation of her identity.

In *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983), the Sixth Circuit was called upon to interpret Michigan's common-law right to publicity. The case involved a manufacturer who used the words, "Here's Johnny," on portable toilets. *Id.* at 832-33. These same words were used to introduce the star of a popular late-night television program. There was nothing to indicate that this use of the phrase on the portable toilets was not associated with Johnny Carson's television program. The court found that "[h]ere there was an appropriation of Carson's identity," which violated the right to publicity. *Id.* at 837.

The common theme in these federal cases is that identifying characteristics unique to the plaintiffs were used in a context in which they were the only information as to the identity of the individual. The commercial advertisements in each case showed attributes of the plaintiff's identities which made it appear that the plaintiff was the person identified in the commercial. No effort was made to dispel the impression that the plaintiffs were

the source of the personal attributes at issue. The commercials affirmatively represented that the plaintiffs were involved. *See, e.g., Midler* at 462 ("The [Motschenbacher] ad suggested that it was he. . . . In the same way the defendants here used an imitation to convey the impression that Midler was singing for them."). The proper interpretation of *Motschenbacher, Midler,* and *Carson* is that where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an ad, a triable issue of fact has been raised as to whether his or her identity as been appropriated.

The case before this court is distinguishable from the factual showing made in *Motschenbacher, Midler,* and *Carson.* It is patently clear to anyone viewing the commercial advertisement that Vanna White was not being depicted. No reasonable juror could confuse a metal robot with Vanna White.

The majority contends that "the individual aspects of the advertisement . . . [v]iewed together leave little doubt about the celebrity the ad is meant to depict." Majority Opinion at p. 9929. It derives this conclusion from the fact that Vanna White is "the only one" who "dresses like this, turns letters, and does this on the Wheel of Fortune game show." *Id.* In reaching this conclusion, the majority confuses Vanna White, the person, with the role she has assumed as the current hostess on the "Wheel of Fortune" television game show. A recognition of the distinction between a performer and the part he or she plays is essential for a proper analysis of the facts of this case. As is discussed below, those things which Vanna White claims identify her are not unique to her. They are, instead, attributes of the *role* she plays. The representation of those attributes, therefore, does not constitute a representation of Vanna White. *See Nurmi v. Peterson,* 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989) (distinguishing between performer and role).

Vanna White is a one-role celebrity. She is famous solely for appearing as the hostess on the "Wheel of Fortune" television show. There is nothing unique about Vanna White or the attributes which she claims identify her. Although she appears to be an attractive woman, her face and figure are no more distinctive than that of other equally comely women. She performs her role as

hostess on "Wheel of Fortune" in a simple and straight-forward manner. Her work does not require her to display whatever artistic talent she may possess.

The majority appears to argue that because Samsung created a robot with the physical proportions of an attractive woman, posed it gracefully, dressed it in a blond wig, an evening gown, and jewelry, and placed it on a set that resembles the Wheel of Fortune layout, it thereby appropriated Vanna White's identity. But an attractive appearance, a graceful pose, blond hair, an evening gown, and jewelry are attributes shared by many women, especially in Southern California. These common attributes are particularly evident among game-show hostesses, models, actresses, singers, and other women in the entertainment field. They are not unique attributes of Vanna White's identity. Accordingly, I cannot join in the majority's conclusion that, even if viewed together, these attributes identify Vanna White and, therefore, raise a triable issue as to the appropriation of her identity.

The only characteristic in the commercial advertisement that is not common to many female performers or celebrities is the imitation of the "Wheel of Fortune" set. This set is the only thing which might possibly lead a viewer to think of Vanna White. The Wheel of Fortune set, however, is not an attribute of Vanna White's identity. It is an identifying characteristic of a television game show, a prop with which Vanna White interacts in her role as the current hostess. To say that Vanna White may bring an action when another blond female performer or robot appears on such a set as a hostess will, I am sure, be a surprise to the owners of the show. *Cf. Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n,* 895 F.2d 663 (7th Cir. 1986) (right to publicity in videotaped performances preempted by copyright of owner of telecast).

The record shows that Samsung recognized the market value of Vanna White's identity. No doubt the advertisement would have been more effective if Vanna White had appeared in it. But the fact that Samsung recognized Vanna White's value as a celebrity does not necessarily mean that it appropriated her identity. The record shows that Samsung dressed a robot in a costume usually worn by television game-show hostesses, including Vanna White.

A blond wig, and glamorous clothing are not characteristics unique to the current hostess of Wheel of Fortune. This evidence does not support the majority's determination that the advertisement was meant to depict Vanna White. The advertisement was intended to depict a robot, playing the role Vanna White currently plays on the Wheel of Fortune. I quite agree that anyone seeing the commercial advertisement would be reminded of Vanna White. *Any* performance by another female celebrity as a game-show hostess, however, will also remind the viewer of Vanna White because Vanna White's celebrity is so closely associated with the role. But the fact that an actor or actress became famous for playing a particular role has, until now, never been sufficient to give the performer a proprietary interest in it. I cannot agree with the majority that the California courts, which have consistently taken a narrow view of the right to publicity, would extend law to these unique facts.

III. *THE LANHAM ACT*

Vanna White's Lanham Act claim is easily resolved by applying the proper legal standard. Vanna White seeks damages for violation of section 43(a) of the Lanham Act. To succeed, Vanna White must prove actual deception of the consuming public. *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 208 (9th Cir. 1989) (claim for damages under section 43(a) requires showing the defendant "actually deceived a significant portion of the consuming public."); *see also PBX Enterprises, Inc. v. Audiofidelity Enterprises, Inc.*, 818 F.2d 266, 271 (2d Cir. 1987) ("to establish entitlement to damages for violation of section 43(a): [Plaintiffs] must establish actual confusion or deception resulting from the violation."); J. Gilson, Trademark Protection and Practice section 7.02[8] at 7-137 to 7-138 (1991) (plaintiffs must show actual deception to obtain damages under section 43(a)). Vanna White offered no evidence that any portion of the consuming public was deceived. The district court was correct in granting summary judgment on Vanna White's Lanham Act claim.

The majority finds that because a majority of factors set forth in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), favor Vanna White, the district court erred in granting summary judgment.

The *AMF* test is designed to aid in determining whether two marks are so sufficiently similar that it is likely that a consumer would confuse them. Where the marks are so obviously different that no confusion could possibly occur, the test is unnecessary. That is the situation in this matter. The attempt to use the Lanham Act to prevent "misappropriations" of which a court does not approve results in the distortion of the law which makes it more difficult to apply the law in appropriate cases. *See* Hanson & Walls, Protecting Trademark Goodwill: Towards a Federal Standard of Misappropriation, 81 Trademark Rep. 480, 511-513 (1991). This case is an example of such distortion.

The majority assumes the conclusion that the *AMF* test is designed to disclose. In repeatedly stating that the robot "identifies" Vanna White, the majority has usurped the fact finding function of the district court.

The majority holds that the first factor of the *AMF* test, strength of the mark, weighs in Vanna White's favor. It equates this factor with the strength of Vanna White's fame, citing *Allen v. National Video, Inc.*, 610 F. Supp. 612 (D.C. N.Y. 1985). *Allen* involved a celebrity look-alike who bore a remarkable resemblance to Woody Allen. *Id.* at 617. The instant matter involves a robot that bears no resemblance to Vanna White.

It is unclear whether the "mark" for which Vanna White seeks protection is her screen image or the imitation Wheel of Fortune. Although Vanna White is certainly famous for being famous, there is no evidence in the record that consumers identify the specific characteristics at issue, i.e., blond hair and fancy dress, solely with Vanna White. The majority ignores this important distinction.

The majority has glossed over the third *AMF* factor—similarity of the marks—the most important factor in this case. The majority finds this factor "ambiguous" because the common characteristics "identify" Vanna White. Majority Opinion at p. 9932. We are required, however, to compare marks in their entirety. *California Cooler, Inc. v. Loretto Winery*, 774 F.2d 1451 (9th Cir. 1985). In this matter, the consumer is confronted with

two entities. One is Vanna White. The other is a robot. No one could reasonably confuse the two.

Certain aspects of a mark may have a greater impact than other aspects. When a mark has certain salient characteristics, they are given greater weight. *Country Floors, Inc. v. Gepner*, 930 F.2d 1056 (3d Cir. 1991); *Henri's Food Products Co. v. Kraft, Inc.*, 717 F.2d 352 (7th Cir. 1983); *Giant Food, Inc. v. Nations' Foodservice, Inc.*, 710 F.2d 1565 (Fed. Cir. 1983). The face of Vanna White and the features of the robot are obviously more important characteristics than their hair, dress, physical proportions, jewelry, or the decoration of the set. Thus, the features of the robot and Vanna White should be given great weight in the analysis. It should be clear to anyone viewing the commercial advertisement that the crude features of the robot are very dissimilar to Vanna White's attractive and human face.

The majority's analysis of the intent or seventh factor in *AMF* is similarly suspect. The question presented here is whether there is any evidence in the record that Samsung intended to confuse consumers. It did not.

Where the circumstances are sufficient to eliminate any likelihood of confusion, this court has repeatedly held that there is no claim for a violation of the Lanham Act. *See Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1980) ("Bagzilla" garbage bags did not infringe "Godzilla" mark); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), *cert. denied sub nom O'Neill v. Walt Disney Prods.*, 439 U.S. 1132 (1979) ("Silly Sympathies" in adult comic books did not infringe on Disney's "Silly Symphonies"). The use of a robot in the commercial advertisement makes it clear that Vanna White did not endorse Samsung's product.

Although likelihood of confusion may usually be a factual question, "courts retain an important authority to monitor the outer limits of substantial similarity within which a jury is permitted to make the factual determination whether there is a likelihood of confusion." *Warner Bros., Inc. v. American Broadcasting Cos., Inc.*, 720 F.2d 231, 246 (2d Cir. 1983). "[S]ummary judgment is appropriate if the court is satisfied that

the products or marks are so dissimilar that no question of fact is presented." *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F.2d 112 (2d Cir. 1984).

"There is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). Vanna White has presented no evidence of actual deception. Thus, she has failed to raise a genuine issue of material fact that would support her Lanham Act claim.

IV. *SAMSUNG'S FIRST AMENDMENT DEFENSE*

The majority gives Samsung's First Amendment defense short shrift because "[t]his case involves a true advertisement run for the purpose of selling Samsung VCRs." Majority opinion at p. 9934. I respectfully disagree with the majority's analysis of this issue as well.

The majority's attempt to distinguish this case from *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988), and *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987), is unpersuasive. The majority notes that the parodies in those cases were made for the purpose of poking fun at the Reverend Jerry Falwell and L.L. Bean. But the majority fails to consider that the defendants in those cases were making fun of the Reverend Jerry Falwell and L.L. Bean for the purely commercial purpose of selling soft-core pornographic magazines.

Generally, a parody does not constitute an infringement on the original work if it takes no more than is necessary to "conjure up" the original. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 756 (9th Cir. 1978). The majority has failed to consider these factors properly in deciding that Vanna White may bring an action for damages solely because the popularity of the fame show, Wheel of Fortune.

The effect of the majority's holding on expressive conduct is difficult to estimate. The majority's position seems to allow any famous person or entity to bring suit based on any commercial advertisement that depicts a character or role performed by the plaintiff. Under the majority's view of the law, Gene Autry could

have brought an action for damages against all other singing cowboys. Clint Eastwood would be able to sue anyone who plays a tall, softspoken cowboy, unless, of course, Jimmy Stewart had not previously enjoined Clint Eastwood. Johnny Weismuller would have been able to sue each actor who played the role of Tarzan. Sylvester Stallone could sue actors who play bluecollar boxers. Chuck Norris could sue all karate experts who display their skills in motion pictures. Arnold Schwarzenegger could sue body builders who are compensated for appearing in public.

The majority's reading of the Lanham Act would provide a basis for "commercial" enterprises to maintain an action for section 43(a) violations even in the absence of confusion or deception. May Black and Decker, maker of the "Dustbuster" portable vacuum, now sue "Bust-dusters," the Los Angeles topless cleaning service. Can the Los Angeles Kings hockey team state a cause of action against the City of Las Vegas for its billboards reading "L.A. has the Kings, but we have the Aces."

Direct competitive advertising could also be effected. Will BMW, which advertises its automobiles as "the ultimate driving machine," be able to maintain an action against Toyota for advertising one of its cars as "the ultimate saving machine"? Can Coca Cola sue Pepsi because it depicted a bottle of Coca Cola in its televised "taste test"? Indeed, any advertisement which shows a competitor's product, or any recognizable brand name, would appear to be liable for damages under the majority's view of the applicable law. Under the majority's analysis, even the depiction of an obvious facsimile of a competitor's product may provide sufficient basis for the maintenance of an action for damages.

V. *CONCLUSION*

The protection of intellectual property presents the courts with the necessity of balancing competing interests. On the one hand, we wish to protect and reward the work and investment of those who create intellectual property. In so doing, however, we must prevent the creation of a monopoly that would inhibit the creative expressions of others. We have traditionally balanced those interests by allowing the copying of an idea, but protecting a unique expression of it. Samsung clearly used the idea of a glamorous

female game show hostess. Just as clearly, it avoided appropriating Vanna White's expression of that role. Samsung did not use a likeness of her. The performer depicted in the commercial advertisement is unmistakably a lifeless robot. Vanna White has presented no evidence that any consumer confused the robot with her identity. Indeed, no reasonable consumer could confuse the robot with Vanna White or believe that, because the robot appeared in the advertisement, Vanna White endorsed Samsung's product.

I would affirm the district court's judgment in all respects.

APPENDIX B

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

VANNA WHITE,
Plaintiff-Appellant,

v.

SAMSUNG ELECTRONICS AMERICA, INC.; DAVID DEUTSCH ASSOCIATES,
Defendants-Appellees.

No. 90-55840

D.C. No. CV-88-6499-RSL

ORDER AND DISSENT

Filed March 18, 1993

Before: Alfred T. Goodwin, Harry Pregerson and Arthur L. Alarcon, Circuit Judges

Dissent by Judge Kozinski

ORDER

The panel has voted unanimously to deny the petition for rehearing. Judge Pregerson has voted to reject the suggestion for rehearing en banc, and Judge Goodwin so recommends. Judge Alarcon has voted to accept the suggestion for rehearing en banc.

The full court has been advised of the suggestion for rehearing en banc. An active judge requested a vote on whether to rehear the matter en banc. The matter failed to receive a majority of the votes of the nonrecused active judges in favor of en banc consideration. Fed. R. App. P. 35.

The petition for rehearing is DENIED and the suggestion for rehearing en banc is REJECTED.

DISSENT

KOZINSKI, Circuit Judge, with whom Circuit Judges O'SCANNLAIN and KLEINFELD join, dissenting from the order rejecting the suggestion for rehearing en banc.

I

Saddam Hussein wants to keep advertisers from using his picture in unflattering contexts.[1] Clint Eastwood doesn't want tabloids to write about him.[2] Rudolf Valentino's heirs want to control his film biography.[3] The Girl Scouts don't want their image soiled by association with certain activities.[4] George Lucas wants to keep Strategic Defense Initiative fans from calling it "Star Wars."[5] Pepsico doesn't want singers to use the word "Pepsi" in their songs.[6] Guy Lombardo wants an exclusive prop-

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[1] *See* Eben Shapiro, *Rising Caution on Using Celebrity Images,* N.Y. Times, Nov. 4, 1992, at D20 (Iraqi diplomat objects on right of publicity grounds to ad containing Hussein's picture and caption "History has shown what happens when one source controls all the information").

[2] *Eastwood v. Superior Court,* 149 Cal. App. 3d 409, 198 Cal. Rptr. 342 (1983).

[3] *Guglielmi v. Spelling-Goldberg Prods.,* 25 Cal. 3d 860, 160 Cal. Rptr. 352, 603 P.2d 454 (1979) (Rudolph Valentino); *see also Maheu v. CBS, Inc.,* 201 Cal. App. 3d 662, 668, 247 Cal. Rptr. 304 (1988) (aide to Howard Hughes). *Cf.* Frank Gannon, *Vanna Karenina* in *Vanna Karenina and Other Reflections* (1988) (A humorous short story with a tragic ending. "She thought of the first day she had met VR SKY. How foolish she had been. How could she love a man who wouldn't even tell her all the letters in his name?").

[4] *Girl Scouts v. Personality Posters Mfg.,* 304 F. Supp. 1228 (S.D.N.Y. 1969) (poster of a pregnant girl in a Girl Scout uniform with the caption "Be Prepared").

[5] *Lucasfilm Ltd. v. High Frontier,* 622 F. Supp. 931 (D.D.C. 1985).

[6] Pepsico Inc. claimed the lyrics and packaging of grunge rocker Tad Doyle's "Jack Pepsi" song were "offensive to [it] and [are] likely to offend [its] customers," in part because they "associate [Pepsico] and its Pepsi marks with intoxication and drunk driving." Russell, *Doyle*

Leaves Pepsi Thirsty for Compensation, Billboard, June 15, 1991, at 43. Conversely, the Hell's Angels recently sued Marvel Comics to keep it from publishing a comic book called "Hell's Angel," starring a character of the same name. Marvel settled by paying $35,000 to charity and promising never to use the name "Hell's Angel" again in connection with any of its publications. *Marvel, Hell's Angels Settle Trademark Suit,* L.A. Daily J., Feb. 2, 1993, § II, at 1.

Trademarks are often reflected in the mirror of our popular culture. *See* Truman Capote, *Breakfast at Tiffany's* (1958); Kurt Vonnegut, Jr., *Breakfast of Champions* (1973); Tom Wolfe, *The Electric Kool-Aid Acid Test* (1968) (which, incidentally, includes a chapter on the Hell's Angels); Larry Niven, *Man of Steel, Woman of Kleenex in All the Myriad Ways* (1971); *Looking for Mr. Goodbar* (1977); *The Coca-Cola Kid* (1985) (using Coca-Cola as a metaphor for American commercialism); *The Kentucky Fried Movie* (1977); *Harley Davidson and the Marlboro Man* (1991); *The Wonder Years* (ABC 1988-present) ("Wonder Years" was a slogan of Wonder Bread); Tim Rice & Andrew Lloyd Webber, *Joseph and the Amazing Technicolor Dream Coat* (musical).

Hear Janis Joplin, *Mercedes Benz, on Pearl* (CBS 1971); Paul Simon, *Kodachrome, on There Goes Rhymin' Simon* (Warner 1973); Leonard Cohen, *Chelsea Hotel, on The Best of Leonard Cohen* (CBS 1975); Bruce Springsteen, *Cadillac Ranch, on The River* (CBS 1980); Prince, *Little Red Corvette, on 1999* (Warner 1982); dada, *Dizz Knee Land, on Puzzle* (IRS 1992) ("I just robbed a grocery store—I'm going to Disneyland / I just flipped off President George—I'm going to Disneyland"); Monty Python, *Spam, on The Final Rip Off* (Virgin 1988); Roy Clark, *Thank God and Greyhound [You're Gone], on Roy Clark's Greatest Hits Volume I* (MCA 1979); Mel Tillis, *Coca-Cola Cowboy, on The Very Best of (MCA 1981)* ("You're just a Coca-Cola cowboy / You've got an Eastwood smile and Robert Redford hair . . . ").

Dance to Talking Heads, *Popular Favorites 1976-92: Sand in the Vaseline* (Sire 1992); Talking Heads, *Popsicle, on id. Admire* Andy Warhol, *Campbell's Soup Can. Cf.* REO Speedwagon, 38 Special, and Jello Biafra of the Dead Kennedys.

The creators of some of these works might have gotten permission from the trademark owners, though it's unlikely Kool-Aid relished being connected with LSD, Hershey with homicidal maniacs, Disney with armed robbers, or Coca-Cola with cultural imperialism. Certainly no free society can *demand* that artists get such permission.

erty right to ads that show big bands playing on New Year's Eve.[7] Uri Geller thinks he should be paid for ads showing psychics bending metal through telekinesis.[8] Paul Prudhomme, that household name, thinks the same about ads featuring corpulent bearded chefs.[9] And scads of copyright holders see purple when their creations are made fun of.[10]

Something very dangerous is going on here. Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors. But reducing too much to private property can be bad medicine. Private land, for instance, is far more useful if separated from other private land by public streets, roads and highways. Public parks, utility rights-of-way and sewers reduce the amount of land in private hands, but vastly enhance the value of the property that remains.

So too it is with intellectual property. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator

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[7] *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977).

[8] *Geller v. Fallon McElligott*, No. 90-Civ-2839 (S.D.N.Y. July 22, 1991) (involving a Timex ad).

[9] *Prudhomme v. Procter & Gamble Co.*, 800 F. Supp. 390 (E.D. La. 1992).

[10] *E.g., Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429 (6th Cir. 1992); *Cliffs Notes v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989); *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986); *MCA, Inc. v. Wilson*, 677 F.2d 180 (2d Cir. 1981); *Elsmere Music, Inc. v. NBC*, 623 F.2d 252 (2d Cir. 1980); *Walt Disney Prods. v. The Air Pirates*, 581 F.2d 751 (9th Cir. 1978); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir. 1964); *Lowenfels v. Nathan*, 2 F. Supp. 73 (S.D.N.Y. 1932).

building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.[11]

The panel's opinion is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority's opinion, it's now a tort for advertisers to *remind* the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright Clause. It raises serious First Amendment problems. It's bad law, and it deserves a long, hard second look.

II

Samsung ran an ad campaign promoting its consumer electronics. Each ad depicted a Samsung product and a humorous prediction: One showed a raw steak with the caption "Revealed to be health food. 2010 A.D." Another showed Morton Downey, Jr. in front of an American flag with the caption "Presidential candidate. 2008 A.D."[12] The ads were meant to convey—humorously—that Samsung products would still be in use twenty years from now.

The ad that spawned this litigation starred a robot dressed in a wig, gown and jewelry reminiscent of Vanna White's hair and dress; the robot was posed next to a Wheel-of-Fortune-like game board. *See* Appendix. The caption read "Longest-running game show. 2012 A.D." The gag here, I take it, was that Samsung would still be around when White had been replaced by a robot.

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[11] *See* Wendy J. Gordon, *A Property Right in Self Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 Yale L.J. ____, Part IV(A) (forthcoming 1993).

[12] I had never heard of Morton Downey, Jr., but I'm told he's sort of like Rush Limbaugh, but not as shy.

Perhaps failing to see the humor, White sued, alleging Samsung infringed her right of publicity by "appropriating" her "identity." Under California law, White has the exclusive right to use her name, likeness, signature and voice for commercial purposes. Cal. Civ. Code § 3344(a); *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 417, 198 Cal. Rptr. 342, 347 (1983). But Samsung didn't use her name, voice or signature, and it certainly didn't use her likeness. The ad just wouldn't have been funny had it depicted White or someone who resembled her—the whole joke was that the game show host(ess) was a robot, not a real person. No one seeing the ad could have thought this was supposed to be White in 2012.

The district judge quite reasonably held that, because Samsung didn't use White's name, likeness, voice or signature, it didn't violate her right of publicity. 971 F.2d at 1396-97. Not so, says the panel majority: The California right of publicity can't possibly be limited to name and likeness. If it were, the majority reasons, a "clever advertising strategist" could avoid using White's name or likeness but nevertheless remind people of her with impunity, "effectively eviscerat[ing]" her rights. To prevent this "evisceration," the panel majority holds that the right of publicity must extend beyond name and likeness, to any "appropriation" of White's "identity"—anything that "evoke[s]" her personality. *Id.* at 1398-99.

III

But what does "evisceration" mean in intellectual property law? Intellectual property rights aren't like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant.[13] They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation. I can't publish unauthorized copies of, say, *Presumed Innocent;* I can't make a movie out of it. But I'm perfectly free to write a

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[13] *Cf., e.g., Guinn v. United States*, 238 U.S. 347, 364-65 (1915) (striking down grandfather clause that was a clear attempt to evade the Fifteenth Amendment).

book about an idealistic young prosecutor on trial for a crime he didn't commit.[14] So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I "eviscerated" Scott Turow's intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy.[15]

The majority isn't, in fact, preventing the "evisceration" of Vanna White's existing rights; it's creating a new and much broader property right, a right unknown in California law.[16] It's

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[14] It would be called "Burden of Going Forward with Evidence," and the hero would ultimately be saved by his lawyer's adept use of Fed. R. Evid. 301.

[15] In the words of Sir Isaac Newton, "[i]f I have seen further it is by standing on [the shoulders] of Giants." Letter to Robert Hooke, Feb. 5, 1675/1676.

Newton himself may have borrowed this phrase from Bernard of Chartres, who said something similar in the early twelfth century. Bernard in turn may have snatched it from Priscian, a sixth century grammarian. *See Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F. Supp. 37, 77 n.3 (D. Mass. 1990).

[16] In fact, in the one California case raising the issue, the three state Supreme Court Justices who discussed this theory expressed serious doubts about it. *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 864 n.5, 160 Cal. Rptr. 352, 355 n.5 (1979) (Bird, C.J., concurring) (expressing skepticism about finding a property right to a celebrity's "personality" because it is "difficult to discern any easily applied definition for this amorphous term").

Neither have we previously interpreted California law to cover pure "identity." *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), dealt with appropriation of a celebrity's voice. *See id.* at 1100-01 (imitation of singing style, rather than voice, doesn't violate the right of publicity). *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), found a violation of the right of publicity, but stressed that, though the plaintiff's likeness wasn't directly recognizable by itself, the surrounding circumstances would have made viewers think the likeness was the plaintiff's. *Id.* at 827; *see also Moore v. Regents of the Univ. of*

replacing the existing balance between the interests of the celebrity and those of the public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to *anything that reminds the viewer of her*. After all, that's all Samsung did: It used an inanimate object to remind people of White, to "evoke [her identity]," 971 F.2d at 1399.[17]

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It's not the robot's wig, clothes or jewelry; there must be ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White's. It's that the robot is posed near the "Wheel of Fortune" game board. Remove the game board from the ad, and no one would think of Vanna White. *See* Appendix. But once you include the game board, anybody standing beside it—a brunette woman, a man wearing women's clothes, a monkey in a wig and gown—would evoke White's image, precisely the way the robot did. It's the "Wheel of Fortune" set, not the robot's face or dress or jewelry that evokes White's image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.[18]

Cal., 51 Cal. 3d 120, 138, 271 Cal. Rptr. 146, 157 (1990) (construing *Motschenbacher* as "hold[ing] that every person has a proprietary interest in his own likeness").

[17] Some viewers might have inferred White was endorsing the product, but that's a different story. The right of publicity isn't aimed at or limited to false endorsements, *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 419-20, 198 Cal. Rptr. 342, 348 (1983); that's what the Lanham Act is for.

Note also that the majority's rule applies even to advertisements that unintentionally remind people of someone. California law is crystal clear that the common-law right of publicity may be violated even by unintentional appropriations. *Id.* at 417 n.6, 198 Cal. Rptr. at 346 n.6; *Fairfield v. American Photocopy Equipment Co.*, 138 Cal. App. 2d 82, 87 (1955).

[18] Once the right of publicity is extended beyond specific physical characteristics, this will become a recurring problem: Outside name,

This is entirely the wrong place to strike the balance. Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.[19]

This is why intellectual property law is full of careful balances between what is set aside for the owner and what's left in the public domain for the rest of us: The relatively short life of patents; the longer, but finite, life of copyrights; copyright's idea-expression dichotomy; the fair use doctrine; the prohibition on copyrighting facts; the compulsory license of television broadcasts and musical compositions; federal preemption of overbroad state intellectual property laws; the nominative use doctrine in trade-

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likeness and voice, the one thing that most reliably reminds the public of someone are the actions or roles they're famous for. A commercial with an astronaut setting foot on the moon would evoke the image of Neil Armstrong. Any masked man on horseback would remind people (over a certain age) of Clayton Moore. And any number of songs—"My Way," "Yellow Submarine," "Like a Virgin," "Beat It," "Michael, Row the Boat Ashore," to name only a few—instantly evoke an image of the person or group who made them famous, regardless of who is singing.

See also Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial*, L.A. Times, Jan. 18, 1990, at B3 (Adam West sues over Batman-like character in commercial); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D. Cal. 1989) (1950s TV movie hostess "Vampira" sues 1980s TV hostess "Elvira"); text accompanying notes 7-8 (lawsuits brought by Guy Lombardo, claiming big bands playing at New Year's Eve parties remind people of him, and by Uri Geller, claiming psychics who can bend metal remind people of him). *Cf. Motschenbacher*, where the claim was that viewers would think plaintiff was actually in the commercial, and not merely that the commercial reminded people of him.

[19] *See generally* Gordon, *supra* note 11.

mark law; the right to make soundalike recordings.[20] All of these diminish an intellectual property owner's rights. All let the public use something created by someone else. But all are necessary to maintain a free environment in which creative genius can flourish.

The intellectual property right created by the panel here has none of these essential limitations: No fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of "appropriation of identity," claims often made by people with a wholly exaggerated sense of their own fame and significance. *See* pp. 1-3 & notes 1-10 *supra*. Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own.[21] The public will be robbed of parodies of

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[20] *See* 35 U.S.C. § 154 (duration of patent); 17 U.S.C. §§ 302-305 (duration of copyright); 17 U.S.C. § 102(b) (idea-expression dichotomy); 17 U.S.C. § 107 (fair use); *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991) (no copyrighting facts); 17 U.S.C. §§ 115, 119(b) (compulsory licenses); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (federal preemption); *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 306-308 (9th Cir. 1992) (nominative use); 17 U.S.C. § 114(b) (soundalikes); *accord G.S. Rasmussen & Assocs. v. Kalitta Flying Serv., Inc.*, 958 F.2d 896, 900 n.7 (9th Cir. 1992); Daniel A. Saunders, Comment, *Copyright Law's Broken Rear Window*, 80 Calif. L. Rev. 179, 204-05 (1992). *But see Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

[21] If Christian Slater, star of "Heathers," "Pump up the Volume," "Kuffs," and "Untamed Heart"—and alleged Jack Nicholson clone—appears in a commercial, can Nicholson sue? Of 54 stories on LEXIS that talk about Christian Slater, 26 talk about Slater's alleged similarities to Nicholson. Apparently it's his nasal wisecracks and killer smiles, St. Petersburg Times, Jan. 10, 1992, at 13, his eyebrows, Ottawa Citizen, Jan. 10, 1992, at E2, his sneers, Boston Globe, July 26, 1991, at 37, his menacing presence, USA Today, June 26, 1991, at 1D, and his sing-song voice, Gannett News Service, Aug. 27, 1990 (or, some say, his insinuating drawl, L.A. Times, Aug. 22, 1990, at F5). That's a whole lot more than White and the robot had in common.

celebrities, and our culture will be deprived of the valuable safety valve that parody and mockery create.

Moreover, consider the moral dimension, about which the panel majority seems to have gotten so exercised. Saying Samsung "appropriated" something of White's begs the question: *Should* White have the exclusive right to something as broad and amorphous as her "identity"? Samsung's ad didn't simply copy White's schtick—like all parody, it created something new.[22] True, Samsung did it to make money, but White does whatever she does to make money, too; the majority talks of "the difference between fun and profit," 971 F.2d at 1401, but in the entertainment industry fun *is* profit. Why is Vanna White's right to exclusive for-profit use of her persona—a persona that might not even be her own creation, but that of a writer, director or producer—superior to Samsung's right to profit by creating its own inventions? Why should she have such absolute rights to control the conduct of others, unlimited by the idea-expression dichotomy or by the fair use doctrine?

To paraphrase only slightly *Feist Publications, Inc. v. Rural Telephone Service Co.*, 111 S. Ct. 1282, 1289-90 (1991), it may seem unfair that much of the fruit of a creator's labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system's very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means by which intellectual property law advances the progress of science and art. We give authors certain exclusive rights, but in exchange we get a richer public domain. The majority ignores this wise teaching, and all of us are the poorer for it.[23]

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[22] *Cf. New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 307 n.6 (9th Cir. 1992) ("Where the infringement is small in relation to the new work created, the fair user is profiting largely from his own creative efforts rather than free-riding on another's work.").

[23] The majority opinion has already earned some well-deserved criticisms on this score. Stephen R. Barnett, *In Hollywood's Wheel of*

IV

The panel, however, does more than misinterpret California law: By refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act. Samsung didn't merely parody Vanna White. It parodied Vanna White appearing in "Wheel of Fortune," a copyrighted television show, and parodies of copyrighted works are governed by federal copyright law.

Copyright law specifically gives the world at large the right to make "fair use" parodies, parodies that do not borrow too much of the original. *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986). Federal copyright law also gives the copyright owner the exclusive right to create (or license the creation of) derivative works, which include parodies that borrow too much to qualify as "fair use." *See Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1434-35 (6th Cir. 1992).[24] When Mel Brooks, for instance, decided to parody *Star Wars*, he had two options: He could have stuck with his fair use rights under 17 U.S.C. § 107, or he could have gotten a license to make a derivative work under 17 U.S.C. § 106(b) from the holder of the *Star Wars* copyright. To be safe, he probably did the latter, but once he did, he was guaranteed a perfect right to make his movie.[25]

Fortune, Free Speech Loses a Turn, Wall St. J., Sept. 28, 1992, at A14; Stephen R. Barnett, *Wheel of Misfortune for Advertisers: Ninth Circuit Misreads the Law to Protect Vanna White's Image*, L.A. Daily J., Oct. 5, 1992, at 6; Felix H. Kent, *California Court Expands Celebrities' Rights*, N.Y.L.J., Oct. 30, 1992, at 3 ("To speak of the 'evisceration' of such a questionable common law right in a case that has probably gone the farthest of any case in any court in the United States of America is more than difficult to comprehend"); Shapiro, *supra* note 1 ("A fat chef? A blond robot in an evening gown? How far will this go?" (citing Douglas J. Wood, an advertising lawyer)).

[24] How much is too much is a hotly contested question, but one thing is clear: The right to make parodies belongs either to the public at large or to the copyright holder, not to someone who happens to appear in the copyrighted work.

[25] *See Spaceballs* (1987). *Compare Madonna: Truth or Dare* (1991) *with Medusa: Dare to Be Truthful* (1991); *Loaded Weapon I* (1993)

The majority's decision decimates this federal scheme. It's impossible to parody a movie or a TV show without at the same time "evok[ing]" the "identit[ies]" of the actors.[26] You can't have a mock *Star Wars* without a mock Luke Skywalker, Han Solo and Princess Leia, which in turn means a mock Mark Hamill, Harrison Ford and Carrie Fisher. You can't have a mock *Batman* commercial without a mock Batman, which means someone emulating the mannerisms of Adam West or Michael Keaton. *See* Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial,* L.A. Times, Jan. 18, 1990, at B3 (describing Adam West's right of publicity lawsuit over a commercial produced under license from DC Comics, owner of the Batman copyright).[27] The public's right to make a fair use parody and the copyright owner's right to license a derivative work are useless if the parodist is held hostage by every actor whose "identity" he might need to "appropriate."

Our court is in a unique position here. State courts are unlikely to be particularly sensitive to federal preemption, which, after all, is a matter of first concern to the federal courts. The Supreme Court is unlikely to consider the issue because the right of publicity seems so much a matter of state law. That leaves us. It's our responsibility to keep the right of publicity from taking away federally granted rights, either from the public at large or from a copyright owner. We must make sure state law doesn't give the

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with Lethal Weapon (1987); *Young Frankenstein* (1974) *with Bride of Frankenstein* (1935).

[26] 17 U.S.C. § 301(b)(1) limits the Copyright Act's preemptive sweep to subject matter "fixed in any tangible medium of expression," but White's identity—her look as the hostess of Wheel of Fortune—is definitely fixed: It consists entirely of her appearances in a fixed, copyrighted TV show. *See Baltimore Orioles v. Major League Baseball Players Ass'n,* 805 F.2d 663, 675 & n.22 (7th Cir. 1986).

[27] *Cf. Lugosi v. Universal Pictures,* 25 Cal. 3d 813, 827-28, 160 Cal. Rptr. 323, 331-32, 603 P.2d 425, 433-34 (1979) (Mosk, J., concurring) (pointing out that rights in characters should be owned by the copyright holder, not the actor who happens to play them); *Baltimore Orioles*, 805 F.2d at 674-79 (baseball players' right of publicity preempted by copyright law as to telecasts of games).

Vanna Whites and Adam Wests of the world a veto over fair use parodies of the shows in which they appear, or over copyright holders' exclusive right to license derivative works of those shows. In a case where the copyright owner isn't even a party—where no one has the interests of copyright owners at heart—the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit.

V

The majority's decision also conflicts with the federal copyright system in another, more insidious way. Under the dormant Copyright Clause, state intellectual property laws can stand only so long as they don't "prejudice the interests of other States." *Goldstein v. California*, 412 U.S. 546, 558 (1973). A state law criminalizing record piracy, for instance, is permissible because citizens of other states would "remain free to copy within their borders those works which may be protected elsewhere." *Id.* But the right of publicity isn't geographically limited. A right of publicity created by one state applies to conduct everywhere, so long as it involves a celebrity domiciled in that state. If a Wyoming resident creates an ad that features a California domiciliary's name or likeness, he'll be subject to California right of publicity law even if he's careful to keep the ad from being shown in California. *See Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538, 1540 (11th Cir. 1983); *Groucho Marx Prods. v. Day and Night Co.*, 689 F.2d 317, 320 (2d Cir. 1982); *see also Factors Etc. v. Pro Arts*, 652 F.2d 278, 281 (2d Cir. 1981).

The broader and more ill-defined one state's right of publicity, the more it interferes with the legitimate interests of other states. A limited right that applies to unauthorized use of name and likeness probably does not run afoul of the Copyright Clause, but the majority's protection of "identity" is quite another story. Under the majority's approach, any time anybody in the United States—even somebody who lives in a state with a very narrow right of publicity—creates an ad, he takes the risk that it might remind some segment of the public of somebody, perhaps somebody with only a local reputation, somebody the advertiser has never heard of. *See* note 17 *supra* (right of publicity is infringed

by unintentional appropriations). So you made a commercial in Florida and one of the characters reminds Reno residents of their favorite local TV anchor (a California domiciliary)? Pay up.

This is an intolerable result, as it gives each state far too much control over artists in other states. No California statute, no California court has actually tried to reach this far. It is ironic that it is we who plant this kudzu in the fertile soil of our federal system.

VI

Finally, I can't see how giving White the power to keep others from evoking her image in the public's mind can be squared with the First Amendment. Where does White get this right to control our thoughts? The majority's creation goes way beyond the protection given a trademark or a copyrighted work, or a person's name or likeness. All those things control one particular way of expressing an idea, one way of referring to an object or a person. But not allowing *any* means of reminding people of someone? That's a speech restriction unparalleled in First Amendment law.[28]

What's more, I doubt even a name-and-likeness-only right of publicity can stand without a parody exception. The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture. Parody, humor,

---

[28] Just compare the majority's holding to the intellectual property laws upheld by the Supreme Court. The Copyright Act is constitutional precisely because of the fair use doctrine and the idea-expression dichotomy, *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 560 (1985), two features conspicuously absent from the majority's doctrine. The right of publicity at issue in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977), was only the right to "broadcast of petitioner's entire performance," not "the unauthorized use of another's name for purposes of trade." *Id.* Even the statute upheld in *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 530 (1987), which gave the USOC sweeping rights to the word "Olympic," didn't purport to protect all expression that reminded people of the Olympics.

irreverence are all vital components of the marketplace of ideas. The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them, or from "evok[ing]" their images in the mind of the public. 971 F.2d at 1399.[29]

The majority dismisses the First Amendment issue out of hand because Samsung's ad was commercial speech. *Id.* at 1401 & n.3. So what? Commercial speech may be less protected by the First Amendment than noncommercial speech, but less protected means protected nonetheless. *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n,* 447 U.S. 557 (1980). And there are very good reasons for this. Commercial speech has a profound effect on our culture and our attitudes. Neutral-seeming ads influence people's social and political attitudes, and themselves arouse political controversy.[30] "Where's the Beef?" turned from an

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[29] The majority's failure to recognize a parody exception to the right of publicity would apply equally to parodies of politicians as of actresses. Consider the case of Wok Fast, a Los Angeles Chinese food delivery service, which put up a billboard with a picture of then-L.A. Police Chief Daryl Gates and the text "When you can't leave the office. Or won't." (This was an allusion to Chief Gates's refusal to retire despite pressure from Mayor Tom Bradley.) Gates forced the restaurant to take the billboard down by threatening a right of publicity lawsuit. Leslie Berger, *He Did Leave the Office—And Now Sign Will Go, Too,* L.A. Times, July 31, 1992, at B2.

See also Samsung Has Seen the Future: Brace Yourself, Adweek, Oct. 3, 1988, at 26 (ER 72) (Samsung planned another ad that would show a dollar bill with Richard Nixon's face on it and the caption "Dollar bill. 2025 A.D.," but Nixon refused permission to use his likeness).

[30] *See, e.g.,* Bruce Horovitz, *Nike Does It Again; Firm Targets Blacks with a Spin on "Family Values",* L.A. Times, Aug. 25, 1992, at D1 ("The ad reinforces a stereotype about black fathers" (quoting Lawrence A. Johnson of Howard University)); Gaylord Fields, *Advertising Awards-Show Mania: CEBA Awards Honors Black-Oriented Advertising,* Back Stage, Nov. 17, 1989, at 1 (quoting the Rev. Jesse Jackson as emphasizing the importance of positive black images in advertising); Debra Kaufman, *Quality of Hispanic Production Rising to Meet Clients'*

advertising catchphrase into the only really memorable thing about the 1984 presidential campaign.[31] Four years later, Michael Dukakis called George Bush "the Joe Isuzu of American politics."[32]

In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared. Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a celebrity's identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add something, perhaps something worthwhile and memorable, perhaps not, to our culture. Both are things that the people being portrayed might dearly want to suppress. *See* notes 1 & 29 *supra*.

Commercial speech is a significant, valuable part of our national discourse. The Supreme Court has recognized as much, and has insisted that lower courts carefully scrutinize commercial speech restrictions, but the panel totally fails to do this. The panel majority doesn't even purport to apply the *Central Hudson* test, which the Supreme Court devised specifically for determining whether a commercial speech restriction is valid.[33] The majority doesn't ask, as *Central Hudson* requires, whether the speech restriction is justified by a substantial state interest. It doesn't ask

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Demands, Back Stage, July 14, 1989, at 1 (Hispanic advertising professional stresses importance of positive Hispanic images in advertising); Marilyn Elias, *Medical Ads Often Are Sexist,* USA Today, May 18, 1989, at 1D ("There's lots of evidence that this kind of ad reinforces stereotypes" (quoting Julie Edell of Duke University)).

[31] *See Wendy's Kind of Commercial; "Where's the Beef" Becomes National Craze,* Broadcasting, March 26, 1984, at 57.

[32] *See* Gregory Gordon, *Candidates Look for Feedback Today, UPI,* Sept. 26, 1988.

[33] Its only citation to *Central Hudson* is a seeming afterthought, buried in a footnote, and standing only for the proposition that commercial speech is less protected under the First Amendment. *See* 971 F.2d at 1401 n.3.

whether the restriction directly advances the interest. It doesn't ask whether the restriction is narrowly tailored to the interest. *See id.* at 566.[34] These are all things the Supreme Court told us—in no uncertain terms—we must consider; the majority opinion doesn't even mention them.[35]

Process matters. The Supreme Court didn't set out the *Central Hudson* test for its health. It devised the test because it saw lower courts were giving the First Amendment short shrift when confronted with commercial speech. *See Central Hudson,* 447 U.S. at 561-62, 567-68. The *Central Hudson* test was an attempt to constrain lower courts' discretion, to focus judges' thinking on the important issues—how strong the state interest is, how broad the regulation is, whether a narrower regulation would work just as well. If the Court wanted to leave these matters to judges' gut feelings, to nifty lines about "the difference between fun and profit," 971 F.2d at 1401, it could have done so with much less effort.

Maybe applying the test would have convinced the majority to change its mind; maybe going through the factors would have shown that its rule was too broad, or the reasons for protecting White's "identity" too tenuous. Maybe not. But we shouldn't thumb our nose at the Supreme Court by just refusing to apply its test.

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[34] *See also Board of Trustees v. Fox,* 492 U.S. 469, 476-81 (1989) (reaffirming "narrowly tailored" requirement, but making clear it's not a "least restrictive means" test).

The government has a freer hand in regulating false or misleading commercial speech, but this isn't such a regulation. Some "appropriations" of a person's "identity" might misleadingly suggest an endorsement, but the mere possibility that speech might mislead isn't enough to strip it of First Amendment protection. *See Zauderer v. Office of Disciplinary Counsel,* 471 U.S. 626, 644 (1985).

[35] Neither does it discuss whether the speech restriction is unconstitutionally vague. *Posadas de P.R. Assocs. v. Tourism Co.,* 478 U.S. 328, 347 (1986).

VII

For better or worse, we *are* the Court of Appeals for the Hollywood Circuit. Millions of people toil in the shadow of the law we make, and much of their livelihood is made possible by the existence of intellectual property rights. But much of their livelihood—and much of the vibrancy of our culture—also depends on the existence of other intangible rights: The right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun, the cultural icons of our time.

In the name of avoiding the "evisceration" of a celebrity's rights in her image, the majority diminishes the rights of copyright holders and the public at large. In the name of fostering creativity, the majority suppresses it. Vanna White and those like her have been given something they never had before, and they've been given it at our expense. I cannot agree.

APPENDIX

Vanna White

Ms. C3PO?

APPENDIX C

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

VANNA WHITE,
Plaintiff,

v.

SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation,
Defendants.

NO. CV 88-6499-RSWL

ORDER

[Filed Nov. 9, 1989]

Defendants in the above captioned action have moved for summary judgment on the first, second and fourth causes of action. [1] Plaintiff timely opposed the motion. The matter was set for oral argument on October 23, 1989 at 9:00 a.m. After review of the papers filed, the Court determined that all of the issues had been adequately briefed and removed the matter from the Court's law and motion calendar pursuant to Fed. R. Civ. P. 78. Now having again reviewed all of the papers filed in support of and in opposition to the motion, the Court hereby issues the following order:

Defendants' motion for summary judgment on the first, second and fourth causes of action is GRANTED.

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[1] Defendants do not expressly so state, but defendants do not address the third cause of action for interference with prospective economic advantage in their moving papers. Therefore the Court construes this motion as being directed toward the first, second and fourth causes of actions only.

BACKGROUND

Plaintiff is the hostess of the television game show entitled "Wheel of Fortune." Defendants published an advertisement which purported to depict the future in a humorous or mildly satiric manner and which told the consumer that defendants' products would be there. The advertisement shows a representation of the "Wheel of Fortune" set and a robot with blonde "hair," over the caption, "Longest Running Game Show. 2012 A.D." A photocopy of the advertisement and a photocopy of a photograph of plaintiff have been submitted.

Plaintiff filed suit, alleging causes of action for violation of California Civil Code §3344, misappropriation of the common law right of publicity, interference with prospective economic advantage, and violation of the Lanham Act §43(a). Defendant now moves for summary judgment on the first, second and fourth causes of action.

FIRST CAUSE OF ACTION—CIVIL CODE §3344

California Civil Code §3344 provides, "Any person who knowingly uses another's name, voice, signature, photograph or likeness, in any manner, . . . for purposes of advertising . . . without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof."

No case has directly construed the meaning of the word "likeness" under §3344. *Nurmi v. Peterson,* 10 U.S.P.Q.2d 1775 (C.D.Cal. March 31, 1989). However *Nurmi, supra,* provides some guidance in the instant case.

In *Nurmi,* the plaintiff was a former 1950s television movie hostess who created and performed a character called Vampira. The defendant was an actress who currently portrays a horror movie hostess called Elvira. The plaintiff alleged that she had developed a character in the 1950s consisting of a distinctive dark dress, certain horror movie props, and a special personality, and that defendants created the character Elvira based upon plaintiff's previously developed character without plaintiff's consent. The plaintiff brought an action based on the Lanham Act §43(a), California Civil Code §3344, and the common law right of

publicity. The defendants moved to dismiss the claims under §3344 and the common law right of publicity. Judge Byrne granted the motion, stating,

> Plaintiff has not alleged that the defendants' character, Elvira, was created to look exactly like the plaintiff's character, Vampira. Rather, the plaintiff claims only that the defendants used certain props, clothes or mannerisms that were similar to those used by the Vampira character. Defendants argue that the use of another character's general characteristics, as opposed to specific facial features, photographs of other exact physical replicas, is not actionable under § 3344 or the common law rights of publicity or privacy.
>
> ... The plaintiff argues that although her name, voice, signature or photograph were not appropriated by the defendants, her "likeness" was used when the defendants created a character that bore an approximate resemblance to Vampira. The defendants contend that the word "likeness" as contemplated by the statute means more than a resemblance but refers instead to an exact copy or portrait of a person. No case has directly construed the meaning of the word "likeness" under §3344 and the parties cite no controlling authority for their contentions.
>
> The Court finds that the defendants' construction of the word "likeness" in § 3344 more faithfully reflects the intent of the statute. Cases which have considered claims arising under § 3344 or closely related right of privacy or publicity actions have implied that the term "likeness" means an actual representation of a person, rather than a close resemblance.
>
> * * *
>
> California cases have also employed the term "likeness" in contexts synonymous with an exact replication of a person's features. In *Lugosi v. Universal Pictures,* 160 Cal. Rptr. 323, 329 [25 Cal.3d 813, 603 P.2d 425] (Cal. 1979), the court discussed at length the descendibility of the right of publicity

> and concluded that a name of likeness unexploited in a person's lifetime did not create a descendible right for his heirs. In making this ruling, the court referred several times to the plaintiff's likeness in terms which were synonymous with actual appearance. Thus, the court observed that while a dracula character that unmistakably bore the plaintiff's features could be subject to a right of publicity action, a generic dracula, which might nevertheless resemble in many ways the plaintiff's character, would not. *Id.* at 325, 329. Consequently, the word "likeness" has been employed by the California Supreme Court to mean an exact copy of another's features and not merely a suggestive resemblance.
>
> * * *
>
> The plaintiff does not allege that the defendants created Elvira to look exactly like Vampira but rather asserts that defendants used some of the plaintiff's props, clothes, and mannerisms. Given these allegations, the Court finds that the defendants did not appropriate the plaintiff's name, voice, signature, photograph or likeness. Thus, the plaintiff's second claim under §3344 is dismissed.

Id. at 1777-1778.

This Court agrees with and adopts the statements of law and the analysis in *Nurmi,* and applies such to the instant case.

If a defendant moves for summary judgment, the judge must ask himself not whether he thinks the evidence unmistakably favors one side or the other but whether a fair-minded jury could return a verdict for the plaintiff on the evidence presented. The mere existence of a scintilla of evidence in support of the plaintiff's position will be insufficient; there must be evidence on which the jury could reasonably find for the plaintiff. *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 252, 106 S.Ct. 2505, 2512 (1986).

In the instant case, no jury could reasonably conclude that the robot is "an actual representation of [plaintiff], rather than a close resemblance," or "an exact copy of [plaintiff's] features and not merely a suggestive resemblance." Therefore summary judg-

ment is granted in defendants' favor on the first cause of action under California Civil Code §3344.

SECOND CAUSE OF ACTION—MISAPPROPRIATION OF COMMON LAW RIGHT OF PUBLICITY

The elements of a common law cause of action for appropriation of name or likeness are (1) the defendant's use of the plaintiff's identity, (2) the appropriation of plaintiff's name or likeness to defendant's commercial advantage, (3) lack of consent, and (4) resulting injury. *Eastwood v. Superior Ct. for Los Angeles Cty.*, 149 Cal.App.3d 409, 417, 198 Cal.Rptr. 342, 347 (1983).

As stated above, no reasonable jury could find that the "likeness" standard adopted by the Court above is satisfied. Therefore summary judgment is granted in defendants' favor on the second cause of action for misappropriation of likeness.

FOURTH CAUSE OF ACTION—LANHAM ACT §43(a)

The Lanham Act §43(a) (15 U.S.C. §1125(a)) provides, "Any person who shall . . . use in connection with any goods . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, . . . shall be liable to a civil action. . . ."

Trademark law is concerned with identification of the maker, sponsor, or endorser of the product so as to avoid confusing consumers. *Intern. Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980). The Lanham Act was meant to prevent consumer confusion as to the relationship between the trademark holder and competitors as to the source of products. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986).

In the instant case, no reasonable jury could find consumers would be confused about whether plaintiff was the maker, sponsor or endorser of the product in the advertisement portraying the robot. Plaintiff and defendants are not competitors and do not market even remotely similar goods or services. Therefore summary judgment is granted in defendants' favor on the fourth cause of action under the Lanham Act §43(a).

IT IS SO ORDERED.

DATED: November 8, 1989.

/s/ Ronald S. W. Lew
RONALD S. W. LEW
United States District Judge

APPENDIX D

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

VANNA WHITE,
Plaintiff,

v.

SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation,
Defendants.

NO. CV 88-6499-RSWL

ORDER

[Filed Dec. 21, 1989]

Plaintiff in the above captioned action has moved for reconsideration of this Court's order filed November 9, 1989 wherein summary judgment was granted in defendants' favor on the first, second and fourth causes of action. Plaintiff moves for reconsideration with respect to the rulings on the second and fourth causes of action only. Defendant timely opposed the motion. The matter was set for oral argument on December 18, 1989 at 9:00 a.m. After review of the papers filed, the Court determined that all of the issues had been adequately briefed and removed the matter from the Court's law and motion calendar pursuant to Fed. R. Civ. P. 78. Now having again reviewed all of the papers filed in support of and in opposition to the motion, the Court hereby issues the following order:

Plaintiff's motion for reconsideration is DENIED, and this Court's order filed November 9, 1989 is hereby affirmed.

DISCUSSION

The second cause of action is for misappropriation of plaintiff's common law right of publicity. The fourth cause of action is brought under the Lanham Act. The Court previously rendered summary judgment in defendants' favor on those causes of action.

Plaintiff now moves for reconsideration of that summary judgment.

Plaintiff submits documents produced by defendants which plaintiff allegedly did not know existed at the time of opposing the motion for summary judgment. These documents show that defendants have referred to the advertisement that is the subject of this action as the " 'Vanna' VCR ad." Plaintiff states that this evidence shows that defendants intended to create an advertisement that caused the viewer to think of plaintiff when viewing the advertisement. However, such a showing of intent is irrelevant. The elements of a common law cause of action for appropriation of name or likeness are (1) the defendant's use of the plaintiff's identify, (2) the appropriation of plaintiff's name or likeness to defendant's commercial advantage, (3) lack of consent, and (4) resulting injury. *Eastwood v. Superior Ct. for Los Angeles Cty.*, 149 Cal.App.3d 409, 417, 198 Cal.Rptr. 342, 347 (1983). The Lanham Act §43(a) (15 U.S.C. § 1125(a)) provides, "Any person who shall . . . use in connection with any goods . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, . . . shall be liable to a civil action . . . ." A showing of a defendant's intent to cause a viewer of an advertisement to think of a plaintiff when viewing an advertisement does not entitle a plaintiff to relief under either of these laws. Thus this argument by plaintiff is meritless.

Plaintiff next argues that, with respect to the common law right of publicity cause of action, this Court's previous ruling is inconsistent with *Motschenbacher v. R.J. Reynolds Tobacco Company*, 498 F.2d 821 (9th Cir. 1974), and *Midler v. Ford Motor Company*, 849 F.2d 460 (9th Cir. 1988). However, these cases are readily distinguishable from the instant case. In *Motschenbacher*, an actual color photograph of the plaintiff's racecar was altered and used in an advertisement, although the facial features of the plaintiff himself were not visible. In the instant case, no photograph of plaintiff, altered or unaltered, was used in the advertisement. In *Midler*, defendants caused a "sound alike" to imitate plaintiff's voice and sing a song which plaintiff, a famous singer, had recorded several years earlier. The song was played with a

commercial on television. The plaintiff withstood a summary judgment motion upon a showing that many people had thought that the plaintiff was actually singing the song played with the commercial. In the instant case, plaintiff does not argue that people think the robot portrayed in the advertisement is actually her.

As stated in the November 9, 1989 order, the parties have cited no case directly construing the meaning of the word "likeness," and the Court has found none, other than *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D.Cal. 1989). *Nurmi* held that the word "likeness" as interpreted by the California courts means "an exact copy of another's features and not merely a suggestive resemblance." *Id.* at 1777. Being forced to render a decision with little guidance, the Court remains in agreement with and again adopts the statements of law and the analysis in *Nurmi*, and affirms the November 9, 1989 rulings with respect to the common law right of publicity cause of action.

Finally, plaintiff argues that the Court must reconsider its grant of summary judgment on the Lanham Act claim because the Court erroneously believed that plaintiff and defendants must be in competition in order for a Lanham Act claim to be viable, and the Court found that plaintiff and defendants were not in competition. Plaintiff is correct in stating that the Lanham Act does not require that plaintiff and defendants actually be in direct competition. However, plaintiff is incorrect in stating that such was the reason the Court granted summary judgment. Rather, the Court found after reviewing the evidence that "no reasonable jury could find that consumers would be confused about whether plaintiff was the maker, sponsor or endorser of the product" in this advertisement. The Court continues to adhere to the view that no reasonable jury could find that this advertisement is not a parody or spoof of "Wheel of Fortune" but rather an endorsement by plaintiff of the product in the advertisement.

Plaintiff relies on *Allen v. National Video, Inc.*, 612 F.Supp. 612 (S.D.N.Y. 1985) in support of her Lanham Act claim; however, that non-binding authority is readily distinguishable from this case. In *Allen*, the defendants used a Woody Allen look alike "that looks remarkably like plaintiff," *Id.* at 617, in an

advertisement; in the instant case, the robot is not and does not resemble a person, but rather is clearly a mechanical figure.

Accordingly, the Court must deny plaintiff's motion for reconsideration and affirm the November 9, 1989 order.

IT IS SO ORDERED.

DATED: December 21, 1989.

/s/ Ronald S. W. Lew
RONALD S. W. LEW
United States District Judge

Supreme Court, U.S.
FILED
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No. 92-1629

In The

Supreme Court of the United States

October Term, 1992

SAMSUNG ELECTRONICS AMERICA, INC.,
a New York corporation, and
DAVID DEUTSCH ASSOCIATES, INC.,
a New York corporation,

Petitioners,

vs.

VANNA WHITE,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Ninth Circuit

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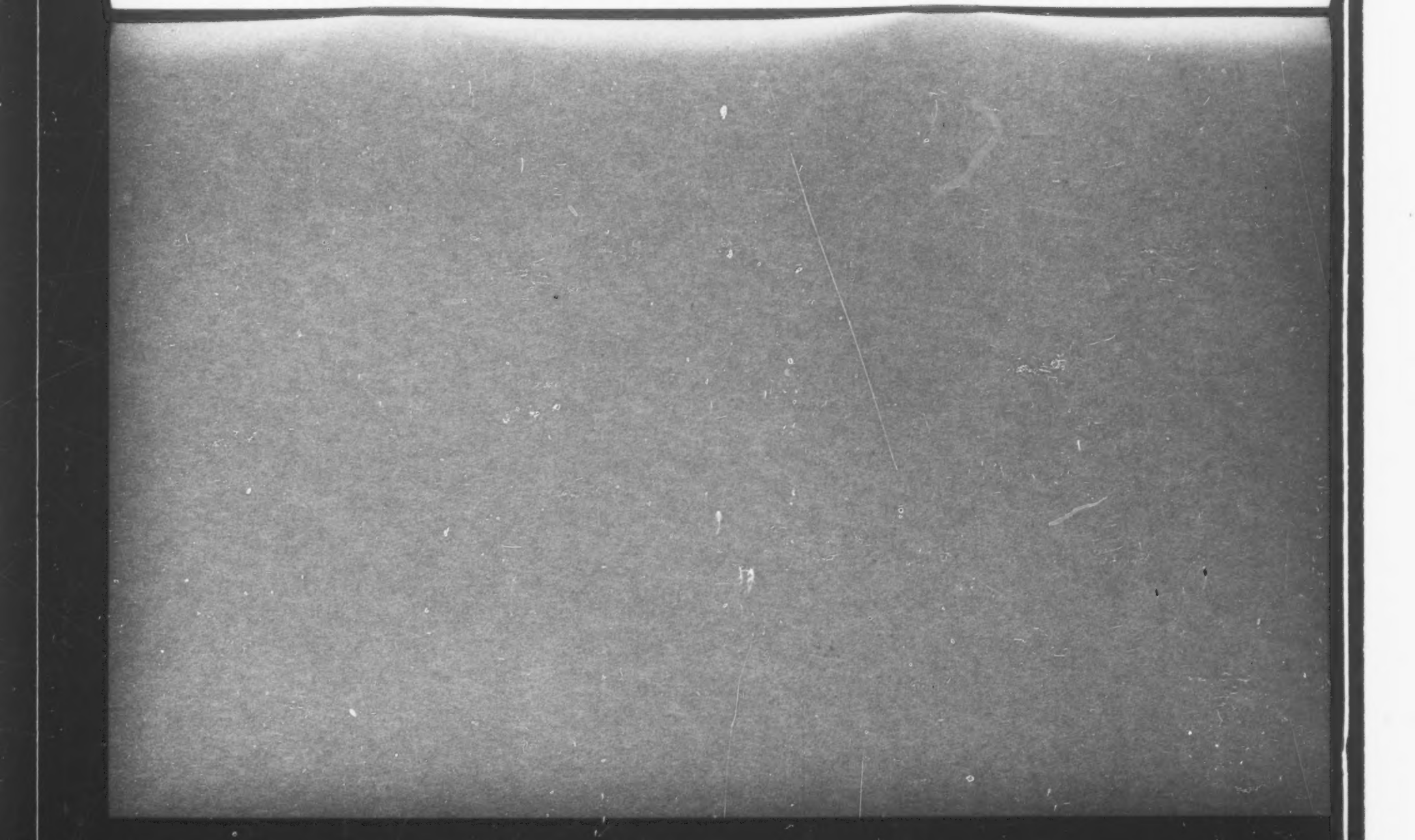

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I

INTRODUCTION AND SUMMARY OF REASONS WHY CERTIORARI SHOULD NOT BE GRANTED

The Petition for a Writ of Certiorari (the "Petition") by defendants Samsung Electronics America, Inc. and David Deutsch Associates, Inc. (collectively "Petitioners" or "Defendants") improperly seeks to invoke the authority of this Court to decide a false issue not in need of Supreme Court resolution. Specifically, Petitioners ask this Court to determine what they now contend to be an important issue of constitutional law that they (1) did not plead, (2) did not argue in support of the summary judgment they obtained in the District Court and (3) only pursued in the District Court and the Court of Appeals in a "perfunctory and undeveloped" manner. Even if Petitioners' "new" issue were procedurally ripe for review, this Court has previously dealt with it and no new Supreme Court direction is necessary.

Petitioners ask this Court to grant certiorari for the purpose of deciding "whether parody in a commercial advertisement is fully protected by the First Amendment." Petition at 5. The Court of Appeals for the Ninth Circuit has held that the advertisement in issue raises a jury question as to whether Petitioners have misappropriated Respondent Vanna White's right to publicity under California common law. Petitioners neglect to inform the Court, however, that *they never even pleaded* any affirmative defense based on the First Amendment, parody, fair use or any other legal principle remotely resembling the issue they now so passionately pursue. They also fail to mention that the grounds upon which they obtained summary judgment against Ms. White on this claim are not

those upon which they now seek review. Indeed, Petitioners' case below – both at the trial and appellate level – turned on a theory in direct conflict with their theory here. For these reasons, this Court should not grant certiorari.

Nor does it need to. Petitioners advertise this case as one of broad import involving an issue on which this Court has never ruled. Using the magic words "chilling effect" to describe the imagined consequences that will plague the advertising community unless this Court takes up the issue, Petitioners claim entitlement to relief. They are wrong on both counts. The significance of the dispute between Petitioners and Vanna White is extremely limited. Perhaps more significantly, this Court has already spoken on the issue Petitioners advance and need not do so again. Accordingly, this matter does not merit the substantive attention of this Court.

II

STATEMENT OF THE CASE

Ms. White has no quarrel with Petitioners' Statement of the Case to the extent it quotes the Court of Appeals' summary of the pertinent facts and District Court proceedings. Petition at 2-3 and Pet. Appx. A at 2-3.[1] However, she does dispute Petitioners' characterization of the Court of Appeals' decision and the validity of the "Questions Presented" by Petitioners. Specifically, Petitioners'

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[1] The appendix attached by Petitioners to the petition is cited here as "Pet. Appx.," while the appendix attached to this brief is cited as "Resp. Appx."

assertion that they properly argued "that their advertisement was a parody that constituted protected speech," Petition at 3, misrepresents the record.[2] Moreover, to the extent that argument was made at all, it was properly rejected by the Court of Appeals after consideration of the applicable authorities, *including authorities never once cited by Petitioners below* but which *now* suddenly form the *entire* basis for their appeal to this Court. Accordingly, the Petition for Writ of Certiorari must be denied.

III

ARGUMENT

This case does not present an issue that merits or requires input from this Court.

A. No "Special And Important" Reasons Justify Supreme Court Attention To This Case.

Petitioners purport to offer two issues for this Court's consideration: (1) whether a "parody" appearing in a commercial advertisement should be "stripped" of its

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[2] While the Court ordinarily does not consider the record unless and until it actually grants certiorari, the fact that it bears on whether to issue the Writ in the first place obligates us to point out certain pertinent facts in the record. S.Ct. Rule 15.1. Accordingly, attached hereto as appendices A, B, C and D, respectively, are true and correct copies of Defendants' answer, their motion for summary judgment to the District Court, their accompanying Statement of Uncontroverted Facts and Conclusions of Law, and their brief to the Ninth Circuit Court of Appeals urging affirmance of the District Court's entry of summary judgment in their favor.

alleged First Amendment protection; and (2) whether the Court below erred in purportedly "summarily reject[ing] any First Amendment defense for 'garden variety commercial speech'. . . . " While stated separately, these "issues" are really one and the same; significantly, however, they fail to acknowledge the important rights of Vanna White infringed by the subject advertisement, which were considered by the Court of Appeals and are implicated now by the review Petitioners ask this Court to undertake. Petitioners pretend that Ms. White's right of publicity, carefully cultivated to enhance and preserve her commercial value as a celebrity spokesperson, is not involved. Because it most assuredly is, the real issue before this Court is whether Petitioners have an absolute right under the First Amendment to misappropriate Ms. White's right of publicity for their own profit in a commercial advertisement without compensating her or obtaining her permission.[3] That issue does not presently require this Court's review.

This Court will grant a writ of certiorari "only when there are special and important reasons therefor." S.Ct. Rule 15.1. The Court may exercise its discretion when "a United States court of appeals has decided an important question of federal law *which has not been*, but *should be*, settled by this Court. . . . " *Id.* Rule 15.1(c) (emphasis added). This is not such a situation.

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[3] In fact, since Petitioners' summary judgment motion in the District Court did not seek a ruling on any affirmative defense at all – much less one based on the First Amendment or some parody theory – even this limited issue has not been resolved below and is consequently not a proper subject for review by this Court.

First, for Petitioners to warn of a "chilling effect" on "all businesses in the country who advertise" (Petition at 5, 7), overstates the implications of what this Court is being asked to consider. Celebrities' rights of publicity have been recognized for quite some time, yet only a handful of cases have surfaced in the area over the past nineteen years. *See, e.g., Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, ___ U.S. ___, 113 S.Ct. 1047, 122 L.Ed.2d 355 (1993); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), *cert. denied, sub nom. Young & Rubicam, Inc. v. Midler*, ___ U.S. ___, 112 S.Ct. 1513, 117 L.Ed.2d 650 (1992); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974); *Eastwood v. Superior Court*, 149 Cal. App. 3d 409 (1983). This Court apparently recognizes this fact, having rejected certiorari petitions in the most recent cases in this area, *Waits* and *Midler*.

Perhaps this is because the Court already *has* spoken on this subject. In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), this Court resolved, in favor of the party who (like Vanna White) sought to enforce his right of publicity, virtually the identical issue raised in the Petition. The Court held that a news organization – asserting a traditionally greater protection for its activities than that afforded commercial speakers like Petitioners – had no First Amendment right to appropriate plaintiff's publicity rights without his permission and without compensating him. Like Ms. White, the plaintiff in *Zacchini* sought only to enforce "the right of the individual to reap the reward of his endeavors" by getting the "commercial benefit of [the] publication . . . of the

very activity by which the entertainer acquired his reputation in the first place." 433 U.S. at 573, 576. Even though Mr. Zacchini's act was broadcast as news, rather than a commercial advertisement, this Court held that the First Amendment does not privilege defendants to make such an appropriation without compensating the entertainer.

Since the only real issue raised by the Petition has already been settled by the Supreme Court, there is no reason to grant the writ Petitioners seek.

B. Petitioner's Arguments Below Directly Contradict Those They Attempt To Raise Here.

In a bold act of legal legerdemain, Petitioners have recently concocted a constitutional issue that they *never even raised as an affirmative defense.* Their answer asserts only two affirmative defenses. They read in full as follows:

> **FIRST AFFIRMATIVE DEFENSE**
>
> Attached hereto as Exhibit "A" is a true and correct copy of the advertisement in issue. This advertisement clearly depicts a robot – i.e., a non-human being – *which could not by any stretch of the imagination be mistaken for plaintiff* and plaintiff's complaint, and each cause of action therein, therefore fails to state a claim upon which relief can be granted.
>
> **SECOND AFFIRMATIVE DEFENSE**
>
> Plaintiff's complaint, and each cause of action therein, fails to state a claim upon which relief can be granted.

Answer, Resp. Appx. A at App. 6 (emphasis added). Fed. R. Civ.P. 8(c) provides that " a party *shall set forth affirmatively* . . . any . . . matter constituting an avoidance or affirmative defense." (Emphasis added.) The appellate courts will refrain from considering a defense not pleaded below as required by Rule 8(c). *See, e.g., Roberts v. College of the Desert*, 870 F.2d 1411, 1414 (9th Cir. 1988); *Walsh v. Mellas*, 837 F. 2d 789, 800 (7th Cir. 1988) *cert. denied*, 486 U.S. 1061 (1988). This Court also held it will not address matters not pleaded or pursued below. *See, e.g., FTC v. Grolier, Inc.*, 462 U.S. 19, 23, n.6 (1983); *Tennessee v. Dunlap*, 426 U.S. 312, 316, n.3 (1976).

Not only is Petitioners' present theory "new," it is *completely inconsistent with the theory they used to obtain summary judgment and to oppose Ms. White's appeal of that decision*. Petitioners' new "parody" argument assumes that their advertisement actually was intended to, and did, "conjure up" (or more directly represent) Vanna White, presumably for the purpose of poking fun at her. *See, e.g., Fisher v. Dees*, 794 F.2d 432, 438-39 (9th Cir. 1986); *Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252, 253, n.1 (2nd Cir. 1980). However, Petitioners have steadfastly defended this action – and, indeed, won a summary judgment in their favor – with the argument that no reasonable person could *possibly* confuse the robot in their ad with Vanna White (the "It's Not Vanna" argument). *See* Answer, Resp. Appx. A at App. 6; Order Granting Summary Judgment, Pet. Appx. C at A-50.

The zeal with which Petitioners pushed their It's Not Vanna position in the District Court and Court of Appeals is manifest. In their summary judgment brief, Petitioners argued:

> It is obvious beyond any doubt . . . that defendants have depicted a non-human robot, *that they chose not to represent Vanna White or any other human being.*
>
> This is so obvious that the claim should be dealt with as a matter of law.

Resp. Appx. B at App. 16-17 (emphasis in original). They went on to argue that judgment should be entered in their favor "because . . . no one could construe the ad as showing the plaintiff, or, indeed, *any* human being." *Id.* at App. 18 (emphasis in original). The "Statement of Uncontroverted Facts and Conclusions of Law" submitted in support of Petitioners' summary judgment motion also directly contravenes – and fails anywhere to mention a single fact in support of – their new parody notion. It states:

* * *

> 4. The robot depicted in said advertisement is not a likeness of plaintiff Vanna White.
>
> 5. A reasonable person could not mistakenly identify, or compare said depiction of a robot with, plaintiff Vanna White.

Resp. Appx. C at App. 27. Petitioners won their summary judgment motion at the trial level because the District Court accepted this argument.

Petitioners repeated the It's Not Vanna argument in their unsuccessful effort to preserve that victory at the appellate level:

> By choosing to use a robot in the advertisement rather than a lady of any age, defendants *intended* to, and *did*, avoid *any representation or inference* that the depiction of the 2012 A.D.

> game show included a depiction of Vanna White or any other human being.

Resp. Appx. D at App. 35 (emphasis added). Petitioners' Ninth Circuit appeal brief also repeated the precise language used in their summary judgment motion: "It is obvious beyond any doubt . . . that defendants depicted a non-human robot, *that they deliberately chose not to represent Vanna White or any other human being.*" *Id.* at App. 37 (emphasis in original). These persistent assertions that the advertisement at issue neither intended to nor did depict Vanna White are wholly antithetical to the parody theory Petitioners now advance in a vain effort to shoulder open a "constitutional" door.

Recognizing this, Petitioners did not seriously pursue below the issue on which they rest their hopes here. Rather, they mentioned this issue only in passing, buried in pages of broad, vague, unexplicated and undifferentiated references to general areas of law, the significance of which they never discussed, perhaps for fear of highlighting the glaring contradiction between their original It's *Not* Vanna theory and their parody theory (which states, in essence, that the ad *does* portray Vanna White, but only in a joking, constitutionally protected way). In both their summary judgment motion and their brief to the Court of Appeals, Petitioners, as an apparent afterthought, suggested (without explaining) that the court's "consideration should be informed by some [without identifying which] principles and concepts in cognate areas: *Freedom of Speech* [followed by $^2/_3$ of a page of string cites] . . . *Public Domain* status of ideas and expression [followed by $^1/_2$ of a page of string cities] . . . *Contract/ Copyright* [followed by $^1/_3$ of a page of string cites]

. . . *Performers' Rights* [followed by 1/2 of a page of string cites] . . . *Artistic Freedom* [followed by 1/2 of a page of string cites] . . . *Fair Use* [followed by a page of string cites] . . . *Humor/Parody Privilege* [followed by 2/3 of a page of string cites]. . . . " *See* Resp. Appx. B and D at App. 23-25 and 44-46. What the courts below could possibly have extracted from this random and unelucidated shotgun approach was not for them to figure out; it was for Petitioners to explain. Having failed to do so, Petitioners cannot now seek this Court's review of hitherto neglected arguments. *See, e.g., Kensington Rock Island v. American Eagle Historic Partners,* 921 F.2d 122, 124-25 (7th Cir. 1990) ("Arguments raised in the District Court in a 'perfunctory and undeveloped . . . manner' are waived on appeal") (citation omitted); *Hays v. Sony Corp. of America,* 847 F.2d 412, 420 (7th Cir. 1988) ("to be preserved, an argument must be *pressed,* and not merely *intimated*") (emphasis added) (citations omitted).

The Ninth Circuit Court of Appeals recognized that Petitioners' appeal focused on the It's Not Vanna theory, not on the premise that the ad is a parody of Ms. White:

> If, *as Samsung claims, its ad was based on a "generic" game-show hostess and not on Vanna White,* the ad would not have violated anyone's right of publicity, but it would also not have been as humorous or effective.

See Ct. App. Order, Pet. Appx. A at A-12, n.3 (emphasis added). Nevertheless, the court accorded the parody issue more attention than Petitioners themselves, ultimately rejecting it as follows:

> Samsung's [parody] argument is unavailing. . . . Unless the first amendment bars all right of publicity actions – and it does not,

> *see Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) – then it does not bar this case.

Id. (citations omitted). As the Court of Appeals properly concluded, Petitioners' own It's Not Vanna arguments and this Court's *Zacchini* decision bar Petitioners from obtaining the relief they now request. Consequently, the petition for writ of certiorari should be denied.

C. The Court Of Appeals Addressed And Properly Decided The Issues Mentioned In The Petition.

Petitioners misapprehend the law they now argue is controlling. They also fail to recognize that the Court of Appeals properly applied that law. Thus, even if Petitioners could overcome the fatal deficiencies discussed above, the Petition should be denied.

First, petitioners mistakenly assert that "a parody is immune from sanction in the form of damages, unless a plaintiff shows a false statement of fact made with 'actual malice,' " citing *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988). Petition at 5. Even if their ad was a parody – an issue that has not been litigated or decided below – the *Hustler* case does not protect it. In *Hustler*, the only cause of action held barred by the First Amendment was one for intentional infliction of emotional distress. The case did not eliminate all tort actions defended on First Amendment grounds, nor did it eviscerate the right of publicity claims at issue here and in *Zacchini*. Indeed, the Court cited *Zacchini* in its *Hustler* opinion, 485 U.S. at 52, thereby recognizing the continued viability of right of

publicity claims challenged on First Amendment grounds.

Petitioners get no further with their sudden reliance on *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980) – a case Petitioners never cited below, but no doubt became enamored of while reading Judge Kozinski's impassioned dissent from the Ninth Circuit's denial of their petition for rehearing *en banc* – or this Court's recent decision in *City of Cincinnati v. Discovery Network, Inc.*, ___ U.S. ___, 61 U.S. Law Week 4272 (Mar. 24, 1993). Neither case affects the viability of Ms. White's cause of action for misappropriation of her right of publicity.

Relying on these cases, Petitioners first make the outrageous assertion that their advertisement is not commercial speech, and thus "deserves full constitutional protection," because it "does not propose a commercial transaction." Petition at 7. Even Judge Kozinski does not go that far. Clearly, the ad "proposes a commercial transaction"; it solicits the purchase of Samsung VCRs. Thus, as this Court has held and the Court of Appeals recognized, the ad constitutes "commercial speech" which merits less constitutional protection than other forms of speech. Pet. Appx. A at A-12, n. 3; *Board of Trustees, State Univ. of N.Y. v. Fox*, 492 U.S. 469, 475 (1989); *Central Hudson*, 447 U.S. at 562-63, n. 5.

Petitioners are thus limited to the argument that the Court of Appeals did not explicitly apply the four part *Central Hudson* analysis. *See* Petition at 8-10. Whether or not the Court of Appeals was *required* to do so point by

point Petitioners do not discuss. Nor have they established that the Court of Appeals did not in fact utilize the *Central Hudson*, analysis. Indeed, the court – on its own – acknowledged the *Central Hudson* case, considered it and determined that it should not alter its conclusion. This was more than Petitioners should have expected, since they never even *cited* the case to the Court of Appeals.

The result below is entirely consistent with *Central Hudson* and *City of Cincinnati*: (1) the ad at issue here constitutes commercial speech; (2) the "governmental interest" in the "regulation" imposed by the common law right of publicity doctrine, which this Court itself has endorsed, is substantial; (3) the "regulation" – a common law cause of action for damages – directly advances that interest; and (4) it is no more extensive than is reasonably necessary to further that interest. *Bd. of Trustees*, 492 U.S. at 477; *Central Hudson*, 447 U.S. at 566. Indeed, as this Court recognized in the context of news stories (which receive full First Amendment protection), a suit to enforce the right of publicity does not *restrict* speech; it simply ensures that the plaintiff who owns and has developed that right is fairly compensated for its use. *Zacchini*, 433 U.S. at 578. In contrast, the *statutory* provision in *City of Cincinnati* and *Central Hudson* completely prohibited certain types of commercial speech. Therefore, these inapposite cases do not justify disturbing the Court of Appeals' carefully considered opinion in this case.

In fact, the Petition's final two and one-half page section is nothing but a bright red herring. Petitioners' claim that "[t]he Court of Appeals has created a dangerous precedent by summarily rejecting any First Amendment defense without applying the *Central Hudson*

test." Petition at 9. This is not true. What's more, it *could not possibly be true.* Petitioners' purported "First Amendment defense" does not appear in their answer, was not a basis of their summary judgment motion in the District Court and thus was never an issue for the Court of Appeals to decide. It is important to remember that this case *has never been tried* and the validity of Petitioners' defenses has never been adjudicated in any court. Consequently, this issue is hardly ripe for consideration by the United States Supreme Court.

Defendant's petition for a writ of certiorari should be denied and Ms. White should be permitted her long overdue day in court.

Respectfully submitted,

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Counsel of Record
JOHN M. GENGA
Counsel for Respondent

HILL WYNNE TROOP & MEISINGER
Of Counsel

APPENDIX A

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Samsung Electronics America, Inc.
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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

VANNA WHITE, Plaintiff, vs. SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation.	CASE NO. 88-06499 RSWL(Sx) ANSWER TO COMPLAINT FOR DAMAGES

COME NOW defendants Samsung Electronics America, Inc., and David Deutsch Associates, Inc., and for answer to the complaint herein admit, deny and allege as follows:

1. Defendants admit the allegations of paragraph 1.

2. Defendants admit the allegations of paragraph 2.

3. Answering paragraph 3, defendants allege they have no information or belief sufficient to enable them to

answer the allegations contained therein, and, basing their denial on that ground, deny generally and specifically, each and every, al [sic] and singular, said allegations.

4. Defendants admit the allegations of paragraph 4.

5. Defendants admit the allegations of paragraph 5.

6. Answering paragraph 6, defendants allege they have no information or belief sufficient to enable them to answer the allegations contained therein, and, basing their denial on that ground, deny generally and specifically, each and every, al [sic] and singular, said allegations.

7. Answering paragraph 7, defendants allege they have no information or belief sufficient to enable them to answer the allegations contained therein, and, basing their denial on that ground, deny generally and specifically, each and every, al [sic] and singular, said allegations.

8. Answering paragraph 8, defendants allege they have no information or belief sufficient to enable them to answer the allegations contained therein, and, basing their denial on that ground, deny generally and specifically, each and every, al [sic] and singular, said allegations.

9. Answering paragraph 9, defendants allege they have no information or belief sufficient to enable them to answer the allegations contained therein, and, basing their denial on that ground, deny generally and specifically, each and every, al [sic] and singular, said allegations.

10. Answering paragraph 10, defendants admit that the subject advertisement was created and caused to be published by defendant David Deutsch Associates, Inc., as advertising agency for defendant Samsung Electronic

America, Inc. Save and except as herein expressly admitted, defendants deny generally and specifically, each and every other allegation contained in paragraph 10.

11. Answering paragraph 11, defendants admit that said advertisement has been published in magazines of general circulation. Save and except as herein expressly admitted, defendants deny generally and specifically, each and every other allegation contained in paragraph 11.

12. Answering paragraph 12, defendants admit that they neither solicited nor received plaintiff's approval of said advertisement and further admit that on occasion they have paid individuals for permission to use their photographs in advertisements. Save and accept as herein expressly admitted, defendants deny generally and specifically, each and every other allegation contained in paragraph 12.

ANSWER TO FIRST CAUSE OF ACTION

13. Answering paragraph 13, defendants refer to and incorporate by said reference as though fully set forth herein all of their answers to paragraphs 1 through 12 herein.

14. Answering paragraph 14, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

15. Answering paragraph 15, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

16. Answering paragraph 16, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

ANSWER TO SECOND CAUSE OF ACTION

17. Answering paragraph 17, defendants refer to and incorporate by said reference as though fully set forth herein all of their answers to paragraphs 1 through 12 and 14 herein.

18. Answering paragraph 18, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

19. Answering paragraph 19, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

20. Answering paragraph 20, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

21. Answering paragraph 21, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

22. Answering paragraph 22, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

ANSWER TO THIRD CAUSE OF ACTION

23. Answer paragraph 23, defendants refer to and incorporate by said reference as though fully set forth

herein all of their answers to paragraphs 1 through 12, 14 and 18 through 20 herein.

24. Answering paragraph 24, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

25. Answering paragraph 25, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

26. Answering paragraph 26, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

27. Answering paragraph 27, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

28. Answering paragraph 28, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

ANSWER TO FOURTH CAUSE OF ACTION

29. Answering paragraph 29, defendants refer to and incorporate by said reference as though fully set forth herein all of their answers to paragraphs 1 through 12, 14, 18 through 20 and 24 through 27 herein.

30. Answering paragraph 30, defendants admit that said advertisement advertises an electronic product which is sold in interstate commerce. Save and except as herein expressly admitted, defendants deny generally and specifically, each and every other allegation contained in paragraph 30.

31. Answering paragraph 31, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

32. Answering paragraph 32, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

33. Answering paragraph 33, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

34. Answering paragraph 34, defendants deny generally and specifically, each and every, all and singular, the allegations contained therein.

35. Answering paragraph 35, defendants denies [sic] generally and specifically, each and every, all and singular, the allegations contained therein.

FIRST AFFIRMATIVE DEFENSE

Attached hereto as Exhibit "A" is a true and correct copy of the advertisement in issue. This advertisement clearly depicts a robot – i.e., a non-human being – which could not by any stretch of anyone's imagination be mistaken for plaintiff and plaintiff's complaint, and each cause of action therein, therefore fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Plaintiff's complaint, and each cause of action therein, fails to state a claim upon which relief can be granted.

WHEREFORE, defendant prays that plaintiff take nothing by said complaint and that said complaint be dismissed, and that it have and recover its costs of suit herein including its attorneys' fees, and for such other and further relief as may be just.

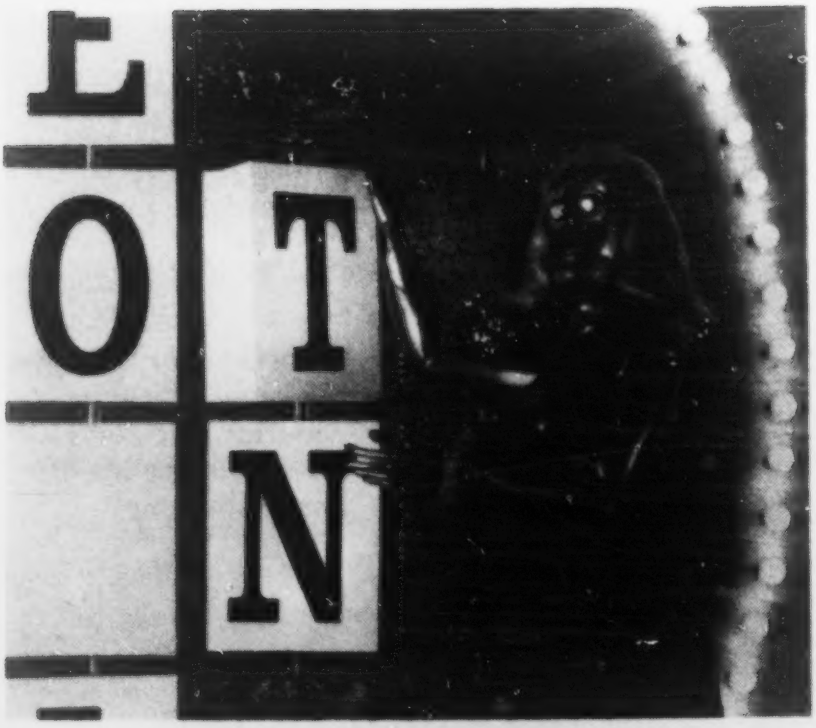
DATED: December 1, 1988

LIEBIG & KULZICK
ANTHONY LIEBIG

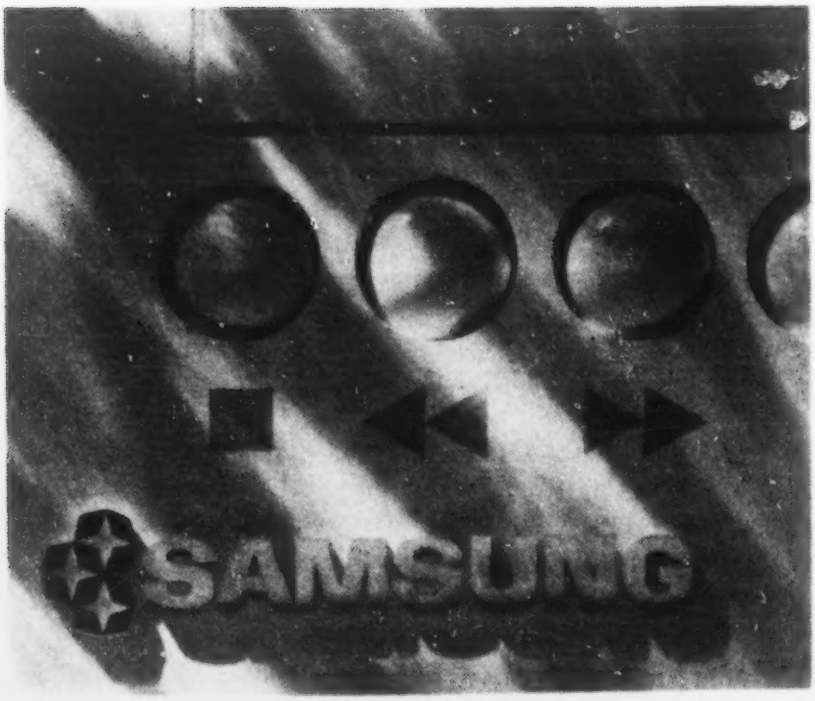
By /s/ Anthony Liebig
Anthony Liebig

Attorneys for Defendants
Samsung Electronics
America, Inc., and
David Deutsch
Associates, Inc.

Exhibit A



Longest-running game show.
2012 A.D.



The VCR you'll tape it on.
2012 A.D.

Samsung. The future of electronics.

APPENDIX B

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

VANNA WHITE, Plaintiff, vs. SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation.	CASE NO. 88-06499 RSWL(Sx) DEFENDANTS' MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT Date: October 9, 1989 Time: 10:00 A.M. Courtroom of the Honorable Ronald S.W. Lew

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Exhibit A – Copy of Advertisement

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I.

INTRODUCTION

This is an action for "commercial misappropriation of likeness" under California Civil Code Section 3344, invasion of the common law right of publicity, interference with prospective economic advantage, and Lanham Act unfair competition.

In essence plaintiff claims defendants wrongfully utilized her "likeness" in a print advertisement.

A true and correct color copy of the accused advertisement is attached as Exhibit A. Plaintiff claims the robot in the top panel is her likeness.

Defendants will depend on plaintiff's attorneys to attach to their response a photograph of plaintiff which they think looks like the robot.

When the advertisement and a real likeness of plaintiff are inspected and compared in the light of the authorities plaintiff must sue under, the Complaint, and each count thereof is revealed to be unprecedented, silly, and subject to summary judgment.

Background Facts

The following facts are not disputed.

"Wheel of Fortune" is a well-known, successful television game show which has run continuously since January 6, 1975. From the show's premiere until the fall of 1982 the hostess on the show was a blonde lady named Susan Stafford. Plaintiff Vanna White, also blonde, has been the hostess on "Wheel of Fortune" since then.

The advertisement in question was one of five "future" advertisements for Samsung Electronics America, Inc., which purported to depict the future in a humorous or mildly satiric manner and told the consumer that Samsung products would be there. The ad shows a representation of the "Wheel of Fortune" set and a *robot* with blonde "hair" over the caption: "Longest-Running Game Show. 2012 A.D."

Defendants' employees who created the ad testified their intention was to portray a 2012 "Wheel of Fortune" with a futuristic robot as the hostess. The advertisement demonstrates they were successful.

Summary of Defendants' Argument

Plaintiff's action must be recognized as a "pioneering effort". Legally, it is vulnerable on three levels of increasing complexity.

On the first, simplest, most obvious level the action may, and should, be disposed of on the ground that defendants' robot could not be mistaken for *any* human being, let alone plaintiff. This was the basis of defendants' earlier motion for Judgment on the Pleadings and is discussed more fully in paragraph II.

On the second level the case is subject to dismissal because the publication of the advertisement could not give rise to an action under Civil Code Section 3344, or constitute a basis for actions for invasion of the right of publicity or interference with prospective economic advantage, because the robot is not a "likeness" of plaintiff within the meaning of Section 3344 and relevant case law. This is discussed more fully in paragraph III.

On the third level the case may be treated and considered as a novel claim and rejected. This is discussed in paragraph IV.

II.

DEFENDANTS ARE ENTITLED TO JUDGMENT BECAUSE THE FIGURE IN THE ADVERTISEMENT IS CLEARLY AND UNMISTAKABLY A ROBOT

All four of plaintiff's counts are predicated on the assertion that an ordinary, reasonable person looking at the Samsung advertisement might believe he is seeing plaintiff Vanna White, that defendants have enlisted her celebrity to grace their ad.

It is obvious beyond any doubt, however, that defendants have depicted a non-human robot, *that they chose not to represent Vanna White or any other human being.*

This is so obvious that the claim should be dealt with as a matter of law. *Scudder Food Products, Inc. v. Ginsberg,* 21 C.2d 596 (1943). *Tomlin v. Walt Disney Productions,* 18 Cal.App.3d 226 (1971). See *International Order of Job's Daughters v. Lindeburg and Company,* 633 F.2d 912 (9th Cir. 1980).

The *Scudder* case is a good analogy because there the plaintiff was complaining that the defendants were confusing customers by using the "same" label. The Superior Court sustained the defendants' demurrer after comparing the labels. The Supreme Court affirmed, stating:

> "While it ordinarily is a question of fact as to whether two containers of labels are so similar as to constitute unfair competition, and it is also ordinarily a question of fact as to whether the public has been or is likely to be mislead, in this case the dissimilarities are so palpable, distinct and clear that it must be held, as a matter of law, that they are not similar, and that the public legally could not be mislead. (21 C.2d at 602). . . . *They are different and the difference is so pronounced that one who runs may read."* (21 C.2d at 600 (emphasis added)) See also: *Don Alvarado Co. v. Porganan,* 203 Cal.App.2d 377 (1962).

In *Tomlin,* the Court also affirmed a summary Judgment predicated in part on its conclusion that "The Love Bug Will Bite You If You Don't Watch Out" was not the same as "Love Bug".

In the copyright area – which is also analogous – the Court's role in comparing the parties' works and deciding against infringement as a matter of law has long

been recognized. See, e.g., *Narell v. Freeman*, 872 F.2d 907, 909-10 (9th Cir. 1989).

III.

DEFENDANTS' ROBOT IS NOT A "LIKENESS" UNDER CALIFORNIA CIVIL CODE SECTION 3344, THE RIGHT OF PUBLICITY CASES, OR THE LANHAM ACT

California Civil Code Section 3344 codified the common law remedy for persons whose names, voices, photographs or "likenesses" were wrongfully used in advertisements to promote the sale of products. As in the case of the tort of invasion of privacy, the essence of the tort is the exposure of the person by the publication of his image. (See, 5 Witkin, *Summary* (9th ed.) Torts p. 685 et seq.).

It is thus not surprising that Section 3344(b)(1) provides:

> "A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use."

Every "likeness" case under Section 3344 has involved *either a photograph or detailed drawing of the plaintiff himself.*

Plaintiff does not have a Section 3344 lawsuit because there is no photograph or other replication of plaintiff and no one could construe the ad as showing the plaintiff, or, indeed, *any* human being.

This is established beyond doubt in two recent cases: *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Nurmi v. Peterson*, 10 U.S.P.Q. 2d 1775 (C.D.Cal. March 31, 1989), copy attached.

In *Midler* the Court held that an *imitation* of a voice, i.e., the use of someone else's similar voice, could not give rise to an action under Section 3344, because, for there to be liability under Section 3344, the person's actual voice had to have been used. (849 F.2d at 463).

In *Nurmi*, the Vampire case, Judge Byrne held that "the use of another character's general characteristics, as opposed to specific facial features, photographs or other exact physical replicas" was not actionable under Section 3344. After reviewing *Midler* and the relevant California authorities Judge Byrne correctly concluded that the term "likeness" in Section 3344 "means an actual representation of a person, rather than a close resemblance." *Nurmi, supra*, at 1777.

Section 3344 was rooted in the common law rights of publicity and privacy. See *Eastwood v. Superior Court*, 149 Cal.App.3d 409, 417, 198 Cal.Rptr. 342, 346 (1983). 5 Witkin, *Summary* (9th ed.) Torts pp. 687 et seq. To maintain a right of publicity claim a plaintiff must prove his name or likeness was used without consent. As in actions under Section 3344, "likeness" means an exact replication. Again, Judge Byrne succinctly stated the issue and its resolution:

> "To maintain a right of publicity claim, a plaintiff must show that his or her name or likeness was appropriated without consent. *Eastwood, supra*, at 347. The plaintiff cites two

cases, *Midler, supra,* and *Chaplin v. Amador,* 269 P. 544 (Cal.App. 1928) for the proposition that the imitation of a distinctive character is actionable under the right of publicity. However, in both of these cases, the courts permitted the plaintiffs to sue only for the defendants' fraudulent attempt to deceive the public into believing that the plaintiffs were actually present. In *Midler,* the court found that plaintiff's voice was duplicated such that the public could be induced to think that she was actually performing in a car commercial. 849 F.2d at 463-64 [7 U.S.P.Q. 2d at 1401]. In *Chaplin,* an imitator attempted to defraud the series of films. 269 P. at 545-46.

Consequently, in both of the cases cited by the plaintiff, a suit was permitted to go forward only on the plaintiffs' fraud claims and not on right of privacy or publicity grounds. Indeed, in *Midler,* as discussed above the plaintiff was precluded from bringing a §3344 claim which is analogous to a common law right of publicity action. Thus, neither case supports the proposition that a person's use of a character that bears a mere resemblance to another is actionable under the common law right of publicity.

In this case, the plaintiff does not allege that the defendants actually tried to copy exactly the Vampira character in creating Elvira. By the plain terms of the complaint, the defendants are alleged to have created a new character that resembled the Vampira character but which used a different name and employed a different actress in the lead role. The Court finds that because these allegations do not amount to the claim that the plaintiff's actual features were

> used by the defendants for commercial purposes, no common law right of publicity or privacy action can be maintained. Thus, the plaintiff's fourth and fifth claims are dismissed." *Nurmi, supra,* at 1778.

The count for Lanham Act unfair competition is predicated upon the assertion that a consumer could "confuse" the whimsical robot in the advertisement with plaintiff Vanna White. Again the ad belies the allegations because the robot is not a "likeness." See authorities cited in paragraph II. As a consequence, plaintiff can establish none of the elements of a cause of action under the Lanham Act; no one could possibly confuse defendants' robot with plaintiff. *Cf. Allen v. Men's World Outlet, Inc.,* 679 F.Supp. 360 (S.D.N.Y. 1988).

Further, by portraying what was obviously a robot in the year 2012, *defendants were clearly saying they were not portraying any human being, including Vanna White.*

IV.

THE COURT SHOULD NOT MAKE NEW LAW FOR VANNA WHITE

Unquestionably this suit is a pioneering effort. There is no statutory or case authority for a cause of action based on an advertisement such as defendants'.

If plaintiff's pioneering effort is to be taken at all seriously, it must be taken *very* seriously, for it raises questions which are both complex and far reaching.

For proper analysis it is imperative to define this claim as accurately as possible and without rhetorical

coloration. At the outset it is important to recognize that plaintiff *cannot* claim that:

1. Defendants used her actual photograph or likeness, or that

2. Defendants produced a figure which could be mistaken for plaintiff, i.e., a masquerade as in *Onassis v. Christian Dior*, 472 N.Y.S. 2d 254 (1984); and *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S. 2d 661 (1977).

The most plaintiff can claim is that persons who saw the ad who were familiar with "Wheel of Fortune" and Vanna White were *reminded* of Vanna White, that is, *by the unconscious process of association*, Vanna White may have popped into their conscious minds. In short, defendants produced an ad which may have made some people *think* briefly about Vanna White while understanding they were not seeing her.

The main triggers for this association are the words "Longest Running Game Show" and the depiction of the "Wheel of Fortune" set. The "blonde" robot probably had some associative effect, but a baboon there would have had as much.

So is the law going to create a cause of action against one who merely causes someone to be thought about by someone else???

In considering this novel question, the Court may take judicial notice of the fact that plaintiff has willingly become "part of the American scene" and her name and image are undoubtedly stored in the unconscious' of many.

If the Court is to take this leap into space, its consideration should be informed by some principles and concepts in cognate areas:

Freedom of Speech. U.S. Constitution, First Amendment. There is no such thing as a false idea or opinion. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 339-40, 41 L.Ed.2d 789, 94 S.Ct. 2997 (1974) "Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles." *Rogers v. Grimaldi,* 695 F.Supp. 112 (S.D.N.Y. 1988). In this regard freedom of commercial speech is alive and well. *Board of Trustees SUNY v. Fox,* 492 U.S. ___, 106 L.Ed.2d 388, 109 S.Ct. ___ (1989).

Public Domain status of ideas and expression. 17 U.S.C. 102(b); *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 11 L.Ed.2d 661, 84 S.Ct. 784 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 11 L.Ed.2d 669, 84 S.Ct. 779 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. ___, 103 L.Ed.2d 118, 109 S.Ct. 971 (1989); *Desny v. Wilder,* 46 C.2d 715 (1956); Liebig, "Copyright Inroads on the Public Domain in the Ninth Circuit", 9 Ent. Law Rptr. No. 7, p.3 (1987)

Contract/Copyright. See *Baltimore Orioles, Inc. v. Major League Baseball Players Assoc.*, 805 F.2d 663 (7th Cir. 1986) which holds that performers' acts, moves, gestures in a copyrighted broadcast are the property of the employer and subsumed by his copyright.

Performers' Rights. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (1970) and *Davis v. Trans*

World Airlines, 297 F. Supp. 1145 (C.D. Cal. 1969) which hold that imitation alone does not give rise to a cause of action; and *KGB, Inc. v. Giannoulas*, 104 Cal.App.3d 844, 856, 164 Cal.Rptr. 571 (1980). See also *Lugosi v. Universal Pictures*, 25 Cal.3d 813, Mosk concurrence at p. 825 (1979), and Liebig, "Style and Performance," 17 Bull. Copyright Society of U.S.A. 40 (1969), which points out that performers always imitate someone.

Artistic Freedom. See *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal.3d 860, conc. opinion at 869 (1979). See also Carlin, "Culture Vultures: Artistic Appropriation and Intellectual Property Law," 13 Columbia-VLA Journal of Law & The Arts 103, which discusses, in legal context, the fact that in recent decades media disseminations have wrought changes in the nature of life and art, our cultural symbols and collective sense of reality, such that artists are compelled to incorporate into their works the popular images that pervade our daily lives.

Fair Use. See 17 U.S.C. §107; "Trademark Parody: A Fair Use and First Amendment Analysis," 72 Va. L. Rev. 1079 (1986).

Humor/Parody Privilege. See *Polygram Records, Inc. v. Superior Court*, 170 Cal.App.3d 543, 552-55 (and Notes 10-14). *Cf. Hustler Magazine v. Falwell*, 485 U.S. 46, 99 L.Ed.2d 41, 108 S.Ct. 876 (1988); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); Dorsen, "Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies without Wrongs," 65 B.U.L. Rev. 923 (1985); "Trademark Parodies and Free Speech: An Expansion of Parodists' First Amendment Rights in *L.L. Bean, Inc. v. Drake*

Publishers, Inc.," 73 Iowa L. Rev. 961 (1988); "*Hustler Magazine, Inc. v. Falwell:* Laugh or Cry, Public Figures Must Learn to Live with Satirical Criticism," 16 Pepperdine L. Rev. 97 (1988).

In peeking into this Pandora's Box the Court should also consider where this uncaged monster might run and how to instruct the jury about it.

V.

CONCLUSION

Defendants are entitled to summary judgment on all counts.

Defendants are entitled to their attorneys fees under California Civil Code Section 3344.

The Court should also consider awarding sanctions under Rule 11 for bringing such a silly case.

DATED: September 15, 1989

Respectfully submitted,

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APPENDIX C

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

VANNA WHITE, Plaintiff, vs. SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation.	CASE NO. 88-06499 RSWL(Sx) STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW Date: October 9, 1989 Time: 10:00 A.M. Courtroom of the Honorable Ronald S.W. Lew

Statement of Uncontroverted Facts

1. Plaintiff Vanna White is a resident of the State of California and defendants Samsung Electronics America, Inc., and David Deutsch Associates, Inc., are both corporations incorporated under the laws of the State of New York.

2. The advertisement at issue, a true and correct copy of which is appended to the Answer herein, was created,

produced, and caused to be included in magazines published throughout the United States by defendants.

3. "Wheel of Fortune" is a well-known, successful television game show. It has been broadcast continually since January 6, 1975. From the show's premier until the fall 1982 the hostess on the show was a blonde lady named Susan Stafford. Since the fall of 1982 plaintiff Vanna White, also a blonde lady, has been the hostess on "Wheel of Fortune".

4. The robot depicted in said advertisement is not a likeness of plaintiff Vanna White.

5. A reasonable person could not mistakenly identify, or confuse said depiction of a robot with, plaintiff Vanna White.

Conclusions of Law

1. The Court has jurisdiction over the parties and the subject matter herein.

2. The depiction of the robot in said advertisement is not a "likeness" of plaintiff within the meaning of California Civil Code Section 3344 or the authorities defining the right of publicity.

3. The creation and publication of said advertisement did not give rise to any known cause of action in favor of plaintiff and against defendants.

4. Defendants are entitled to judgment.

DATED: September 15, 1989

LIEBIG & KULZICK
ANTHONY LIEBIG

By /s/ Anthony Liebig
Anthony Liebig

Attorneys for Defendants
Samsung Electronics
America, Inc. and David
Deutsch Associates, Inc.

APPENDIX D

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

VANNA WHITE, Plaintiff-Appellant, vs. SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and DAVID DEUTSCH ASSOCIATES, INC., a New York corporation. Defendants-Appellees.	CA NO. 90-55840 APPEAL FROM SUMMARY JUDGMENT UNITED STATES DISTRICT COURT, CENTRAL DISTRICT OF CALIFORNIA (Case No. CV-88-06499-RSWL) (Hon. Ronald S. W. Lew, Judge)

BRIEF OF APPELLEES

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5 Witkin, *Summary* (9th ed. 1988) Torts Sections 587 et seq 7, 8

I.

STATEMENT OF JURISDICTION

Defendants/Appellees agree with Plaintiff/Appellant's Statement of Jurisdiction.

II.

STATEMENT OF ISSUE ON APPEAL

Did the District Court err in granting the Defendant/Appellees' Motion for Summary Judgment.

III.

STANDARD OF REVIEW

The standard of review is the same as the standard for ruling on the Motion for Summary Judgment below. It is set forth in *Celotex Corp. v. Catrett*, 477 U.S. 317, 324-26, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250-252, 106 S.Ct. 2505 (1986); and *Matsushita Electric Industrial Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986).

IV.

STATEMENTS OF FACTS

Defendants agree with the basic facts as stated in plaintiff's Opening Brief, but not with plaintiff's skewing; and we would point out several significant omissions.

First and foremost, plaintiff does not fairly characterize the advertisement in question. We therefore attach a copy as an Addendum hereto.

The subject advertisement speaks for itself and no amount of lawyers' rhetoric can change what it says. It will be noted that the 1988 advertisement contains a spoof about a current television game show still being broadcast 24 years hence and being videotaped on a Samsung VCR in 2012 A.D.

The television game show, "Wheel of Fortune," was a well-known, successful show which had run continuously since January 6, 1975. From the show's premiere until the fall of 1982 the hostess on the show was a blonde lady named Susan Stafford. Plaintiff Vanna White, also blonde, has been the hostess of "Wheel of Fortune" since then. If the show were still on the air in 2012 there undoubtedly would have been an intervening series of pretty blond ladies in the hostess role. In 2012 there would probably be a blond hostess who was born around 1988.

By choosing to use a robot in the advertisement rather than a lady of any age, defendants intended to, and did, avoid any representation or inference that the depiction of the 2012 A.D. game show included a depiction of Vanna White or any other human being.

V.

SUMMARY OF DEFENDANTS' ARGUMENT

Plaintiff's action must be recognized as a "pioneering effort" which was undoubtedly inspired by some of the

loose language in this court's decision in *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

Legally, plaintiff's claim is vulnerable on three levels of increasing complexity.

On the first, simplest, most obvious level the action may be disposed of on the ground that defendants' robot could not be mistaken for *any* human being, let alone plaintiff. This was the basis of Judge Lew's ruling below.

On the second level the case lacks validity because the publication of the advertisement could not give rise to an action under California Civil Code Section 3344, or constitute a basis for actions for invasion of the right of publicity or under the Lanham Act, because the robot is not a "likeness" of plaintiff within the meaning of Section 3344 and relevant case law.

On the third level the case may be treated and considered as a novel claim and rejected as contrary to prevailing legal principles and policies.

VI.

ARGUMENT

A. Defendants Were Entitled to Judgment Because the Figure in the Advertisement is Clearly and Unmistakably a Robot

Plaintiff's action was predicated on the assertion that an ordinary, reasonable person looking at the Samsung advertisement might believe he was seeing plaintiff Vanna White, that defendants had enlisted her celebrity to grace their ad.

It is obvious beyond any doubt, however, that defendants depicted a non-human robot, *that they deliberately chose not to represent Vanna White or any other human being.*

This is so obvious that the claim was properly dealt with as a matter of law. *Scudder Food Products, Inc. v. Ginsberg,* 21 C.2d 596 (1943). *Tomlin v. Walt Disney Productions,* 18 Cal.App.3d 226 (1971). See *International Order of Job's Daughters v. Lindeburg and Company,* 633 F.2d 912 (9th Cir. 1980).

The *Scudder,* case is a good analogy because there the plaintiff was complaining that the defendants were confusing customers by using the "same" label. The California Superior Court sustained the defendants' demurrer after comparing the labels. The California Supreme Court affirmed, stating:

> "While it ordinarily is a question of fact as to whether two containers or labels are so similar as to constitute unfair competition, and it is also ordinarily a question of fact as to whether the public has been or is likely to be misled, in this case the dissimilarities are so palpable, distinct and clear that it must be held, as a matter of law, that they are not similar, and that the public legally could not be misled. (21 C.2d at 602). . . . *They are different and the difference is so pronounced that one who runs may read."* (21 C.2d at 600 (emphasis added)) See also: *Don Alvarado Co. v. Porganan,* 203 Cal.App.2d 377 (1962).

In *Tomlin,* the California Court of Appeal also affirmed a summary Judgment predicated in part on its conclusion that "The Love Bug Will Bite You If You Don't Watch Out" was not the same as "Love Bug".

In the copyright area – which is analogous – the Trial Court's role in comparing the parties' works and deciding whether there could be infringement as a matter of law has long been recognized. See, e.g., *Narell v. Freeman*, 872 F.2d 907, 909-10 (9th Cir. 1989).

B. Defendant's Robot is Not a "Likeness" under California Civil Code Section 3344, the Right of Publicity Cases, or the Lanham Act

California Civil Code Section 3344 codified and supplemented the common law remedy for persons whose names, voices, photographs or "likenesses" are wrongfully used in advertisements to promote the sale of products. *Eastwood v. Superior Court*, 149 Cal.App.3d 409, 417 (1983) As in the case of the tort of invasion of privacy, the essence of the tort is the exposure of the person by the publication of his image. (See, 5 Witkin, *Summary* (9th ed. 1988) Torts Sections 587 et seq.).

It is thus not surprising that Section 3344(b)(1) provides:

> "A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use."

Every "likeness" case under Section 3344 has involved *either a photograph or detailed drawing of the plaintiff himself*. Plaintiff cannot change this with word games about "resemblance", "correspondence of appearance of superficial qualities," etc.

Plaintiff does not have a Section 3344 lawsuit because there is no photograph or other replication of plaintiff and no one could construe the ad as showing the plaintiff, or, indeed, *any* human being. This was established beyond doubt in two recent cases: *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Nurmi v. Peterson*, 10 U.S.P.Q. 2d 1775 (C.D.Cal. March 31, 1989).

In *Midler* this Court held that an *imitation* of a voice, i.e., the use of someone else's similar voice, could not give rise to an action under Section 3344, because, for there to be liability under Section 3344, the person's *actual voice* had to have been used. (849 F.2d at 463).

In *Nurmi*, the "Vampira" case, Judge Byrne held that "the use of another character's general characteristics, as opposed to specific facial features, photographs or other exact physical replicas" was not actionable under Section 3344. After reviewing *Midler* and the relevant California authorities Judge Byrne correctly concluded that the term "likeness" in Section 3344 "means an actual representation of a person, rather than a close resemblance." *Nurmi, supra*, at 1777.

Section 3344 was rooted in the common law rights of publicity and privacy. See *Eastwood v. Superior Court, supra*, 5 Witkin, *Summary* (9th Ed. 1988) Torts pp. Sections 589 et seq. To maintain a right of publicity claim a plaintiff must prove his name or likeness was used without consent. As in actions under Section 3344, "likeness" means an exact replication. Again, Judge Byrne succinctly stated the issue and its resolution:

> "To maintain a right of publicity claim, a plaintiff must show that his or her name or likeness

was appropriated without consent. *Eastwood, supra*, at 347. The plaintiff cites two cases, *Midler, supra*, and *Chaplin v. Amador*, 269 P. 544 (Cal.App. 1928) for the proposition that the imitation of a distinctive character is actionable under the right of publicity. However, in both of these cases, the courts permitted the plaintiffs to sue only for the defendants' fraudulent attempt to deceive the public into believing that the plaintiffs were actually present. In *Midler*, the court found that plaintiff's voice was duplicated such that the public could be induced to think that she was actually performing in a car commercial. 849 F.2d at 463-64 [7 U.S.P.Q. 2d at 1041]. In *Chaplin*, an imitator attempted to defraud the series of films. 269 P. at 545-46.

Consequently, in both of the cases cited by the plaintiff, a suit was permitted to go forward only on the plaintiffs' fraud claims and not on right of privacy or publicity grounds. Indeed, in *Midler*, as discussed above, the plaintiff was precluded from bringing a Section 3344 claim which is analogous to a common law right of publicity action. Thus, neither case supports the proposition that a person's use of a character that bears a mere resemblance to another is actionable under the common law right of publicity.

In this case, the plaintiff does not allege that the defendants actually tried to copy exactly the Vampira character in creating Elvira. By the plain terms of the complaint, the defendants are alleged to have created a new character that resembled the Vampira character but which used a different name and employed a different actress in the lead role. The Court finds that

> because these allegations do not amount to the claim that the plaintiff's actual features were used by the defendants for commercial purposes, no common law right of publicity or privacy action can be maintained. Thus, the plaintiff's fourth and fifth claims are dismissed." *Nurmi, supra,* at 1778.

Plaintiff's count for Lanham Act unfair competition is also predicated on the assertion that a consumer could "confuse" the whimsical robot in the advertisement with plaintiff Vanna White. Again the ad belies the allegations because the robot is not a "likeness." As a consequence, plaintiff can establish none of the elements of a cause of action under the Lanham Act; no one could possibly confuse defendants' robot with plaintiff. *Cf. Allen v. Men's World Outlet, Inc.,* 679 F.Supp. 360 (S.D.N.Y. 1988). Further, by portraying what was obviously a robot in the year 2012, *defendants were clearly saying they were not portraying any human being, including Vanna White.*

C. This Court Should Not Make New Law for Vanna White

Unquestionably this suit is a pioneering effort. There is no statutory or case authority for a cause of action based on an advertisement such as defendants'.

Plaintiff is apparently claiming some kind of property interest in something beyond her mere likeness or image – perhaps her style, aura, aurora, gestalt, or penumbra.

If plaintiff's pioneering effort is to be taken at all seriously, it must be taken *very* seriously, for it raises

questions of California and federal law which are both complex and far reaching.

For proper analysis it is imperative to define this claim as accurately as possible and without rhetorical coloration. At the outset it is important to recognize that plaintiff *cannot* claim that:

1. Defendants used her actual photograph or likeness, or that

2. Defendants produced a figure which could be mistaken for plaintiff, i.e., a masquerade as in *Onassis v. Christian Dior*, 472 N.Y.S. 2d 254 (1984).

The *most* plaintiff can claim is that persons who saw the advertisement who were familiar with "Wheel of Fortune" and Vanna White were *reminded* of Vanna White – that is, *by the unconscious process of association*, Vanna White may have popped into their conscious minds. In short, defendants produced an ad which may have made some people *think* briefly about Vanna White while understanding they were not seeing her.

The main triggers for this association are the words "Longest Running Game Show" and staging suggestive of the "Wheel of Fortune" set. The "blonde" robot probably had some associative effect, but a baboon there would have had as much.

Unquestionably plaintiff was asking the Trial Court to create a California cause of action against one who merely caused someone *to be thought about* by someone else.

In her Motion for Reconsideration plaintiff asserted "attributes of her identity"[1] had been appropriated and pointed to evidence indicating that defendants were aware of her existence and her known relationship with "Wheel of Fortune." In denying the Motion Judge Lew stated:

> "A showing of a defendant's intent to cause a viewer of an advertisement *to think of a plaintiff when viewing an advertisement* does not entitle a plaintiff to relief under either of these laws. Thus this argument by plaintiff is meritless."
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> (Order of December 21, 1989, Excerpt of Record, p. 31, emphasis added.)

In considering plaintiff's novel claim, this Court should take judicial notice of the fact that plaintiff eagerly became "part of the American scene." She has become something of a "celebrity" and has profited handsomely. Her name and image are undoubtedly stored in the unconscious' of many. She may even have been "part of

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[1] The term "attributes of one's identity" has been a favorite of imaginative plaintiff's lawyers, and at least one opinion writer, since it was used loosely in *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974). But *Motschenbacher* did not recognize any new California tort stemming from an appropriation of the "attributes of one's identity." *Motschenbacher* was a garden variety privacy/publicity case. There was never any question in *Motschenbacher* as to whether or not the plaintiff could maintain an action for invasion of privacy and/or publicity *if he was identified, that is, if a viewer of the commercial could reasonably deduce his presence inside the pictured racing car.* Judge Real concluded this could not be done and granted Summary Judgment. This Court vacated the Summary Judgment, leaving the question of "identifiability" to the trier of fact.

the cultural history of an era."[2] but she did not become a sacred cow.

The Court's consideration should also be informed by some principles and concepts in cognate areas:

> *Freedom of Speech.* United States Constitution, First Amendment. Whether or not the robot depiction be deemed artistic expression, or, because it appeared in an advertisement, commercial speech, it is entitled to a large measure of protection. *Board of Trustees S.U.N.Y. v. Fox,* 492 U.S. ___, 106 L.Ed.2d 388, 109 S.Ct. 3028 (1989);*U.S. Healthcare v. Blue Cross of Gr. Phil.,* 898 F.2d 914 (3rd Cir. 1990), cert. denied October 1, 1990. "Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles." *Rogers v. Grimaldi,* 875 F.2d 994, 998 (2d Cir. 1989).
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> *Public Domain* status of ideas and expression. 17 U.S.C. 102(b); *Sears Roebuck & Co. v. Stiffel Co.,* 376 U.S. 225, 11 L.Ed.2d 661, 84 S.Ct. 784 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.,* 376 U.S. 234, 11 L.Ed.2d 669, 84 S.Ct. 779 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.,* 489 U.S. ___, 103 L.Ed.2d 118, 109 S.Ct. 971 (1989); *Desny v. Wilder,* 46 C.2d 715 (1956); Liebig, "Copyright Inroads on the Public Domain in the Ninth Circuit", 9 Ent. Law Rptr. No. 7, p.3 (1987)

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[2] *Rogers v. Grimaldi,* 695 F.Supp. 112, 123 (S.D.N.Y. 1988) affirmed at 875 F.2d 994 (2d Cir. 1989)

Contract/Copyright. See *Baltimore Orioles, Inc. v. Major League Baseball Players Assoc.*, 805 F.2d 663 (7th Cir. 1986) which holds that performers' acts and appearance in a copyrighted broadcast are the property of the employer and subsumed by his copyright.

Performers' Rights. That is, the rights of *other* performers. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (1970) and *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969) which hold that imitation alone does not give rise to a cause of action; and *KGB, Inc. v. Giannoulas*, 104 Cal.App.3d 844, 856, 164 Cal.Rptr. 571 (1980). See also *Lugosi v. Universal Pictures*, 25 Cal.3d 813, Mosk concurrence at p. 825 (1979), and Liebig, "Style and Performance," 17 Bull. Copyright Society of U.S.A. 40 (1969), which discusses the inevitability of imitation.

Artistic Freedom. See *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal.3d 860, conc. opinion at 869 (1979). See also Carlin, "Culture Vultures: Artistic Appropriation and Intellectual Property Law," 13 Columbia-VLA Journal of Law & the Arts 103, which discusses, in legal context, the fact that in recent decades media disseminations have wrought changes in the nature of life and art, our cultural symbols and collective sense of reality, such that artists are compelled to incorporate into their works these popular images that pervade our daily lives.

Fair Use. See 17 U.S.C. 107. "The District Court concluded, among other things, that the parody did not make more extensive use of appellant's song than was necessary to 'conjure up' the original. 482 F.Supp. at 747. While we agree with this conclusion, we note that the concept of

'conjuring up' an original came into the copyright law not as a limitation on how much of an original may be used, but as a recognition that a parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point. *Columbia Pictures Corp. v. National Broadcasting Co.*, 137 F. Supp. 348, 354 (S.D. Cal. 1955). A parody is entitled at least to 'conjure up' the original. Even more extensive use would still be fair use, provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary." *Ellesmere Music, Inc., v. National Broadcasting Co.*, 623 F.2d 252 (2d Cir. 1980); See also, *Tin Pan Apple, Inc., v. Miller Brewing Co., Inc.*, 737 F.Supp. 826 (S.D.N.Y. 1990)

Humor/Parody Privilege. See *Polygram Records, Inc. v. Superior Court*, 170 Cal.App.3d 543, 552-55 (and Notes 10-14). *Cf. Hustler Magazine v. Falwell*, 485 U.S. 46, 99 L.Ed.2d 41, 108 S.Ct. 876 (1988); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); Dorsen, "Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies without Wrongs," 65 B.U.L. Rev. 923 (1985); "Trademark Parody: A Fair Use and First Amendment Analysis," 72 Va. L. Rev. 1079 (1986); "Trademark Parodies and Free Speech: An Expansion of Parodists' First Amendment Rights in *L.L. Bean, Inc. v. Drake Publishers, Inc.*," 73 Iowa L. Rev. 961 (1988); "Hustler Magazine, Inc. v. Falwell: Laugh or Cry, Public Figures Must Learn to Live with Satirical Criticism," 16 Pepperdine L. Rev. 97 (1988).

VII.

CONCLUSION

The Judgment below should be affirmed.

DATED: November 2, 1989

Respectfully submitted,

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No. 92-1629

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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1992

SAMSUNG ELECTRONICS AMERICA, INC.,
a New York corporation, and
DAVID DEUTSCH ASSOCIATES, INC.,
a New York corporation,
Petitioners,

VS.

VANNA WHITE,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

PETITIONERS' REPLY BRIEF

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Rules

Federal Rules of Civil Procedure
Rule 8(c). 2

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PETITIONERS' REPLY BRIEF*

1. The Court of Appeals actually considered and decided the question of whether or not petitioners have a First Amendment defense. Respondent Vanna White

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* There have been no material changes in the parents or subsidiaries of petitioners since the petition was filed.

concedes that the Court of Appeals considered and rejected any defense under the First Amendment. Opposition, pp. 3, 10-11; see Pet.Appx. A, pp. 11-12 & n.3. It is an "elementary rule that it is irrelevant to inquire . . . when a Federal question was raised in a court below when it appears that such question was actually considered and decided." Orr v. Orr, 440 U.S. 268, 274-275 (1979). In any event, petitioners did raise their First Amendment concerns in the district court (Opposition Appx. B, pp. 23-25) and the Court of Appeals (Opposition Appx. D, pp. 44-46). See Lucas v. United States, 807 F.2d 414, 417-418 (5th Cir. 1986) ("technical failure to comply" with Fed.R. Civ.P. 8(c) not fatal, where legal issue raised at "pragmatically sufficient time").

2. The Vanna White parody should be protected under the First Amendment. The advertisement is a parody "intended to depict a robot, playing the role Vanna White currently plays on the Wheel of Fortune." Pet.Appx. A, p. 19 (Alarcon, J., dissenting). This Court's decision in Hustler Magazine v. Falwell, 485 U.S. 46 (1988), establishes that such an "ad parody" is protected under the First Amendment. 485 U.S. at 50. A parody need not "depict" or "represent" the person being parodied (see Opposition, pp. 7-9); respondent's own authority recognizes that a parody need only "conjure up" the original person (see Elsmere Music v. National Broadcasting Co., 623 F.2d 252, 253, n.1 (2nd Cir. 1980)). The fact that the Vanna White parody does not actually "depict" or "represent" Vanna White, and instead de-

picts a robot playing her role on Wheel of Fortune, does not in any way lessen its First Amendment protection.

3. Respondent's reliance on *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), is misplaced. Zacchini addressed the unique situation where the media "broadcast a performer's entire act without his consent." 433 U.S. at 575. Zacchini expressly distinguishes that appropriation from the unauthorized use of a person's name or picture:

> "[T]he broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press, goes to the heart of petitioner's ability to earn a living as an entertainer." 433 U.S. at 576.

Thus, Zacchini, by its own terms, does not control here.

4. This Court's recent opinion in *Edenfield v. Fane*, 61 U.S. Law Week 4431 (U.S. Apr. 26, 1993), underscores the need for review of the questions presented. This Court's recent opinion in Edenfield acknowledges that "ambiguities may exist at the margins of the category of commercial speech." 61 U.S. Law Week at 4432. Indeed, as discussed in our petition, this Court's opinions still leave unresolved the precise test for determining what is "commercial speech" or "'core' commercial speech" that may be entitled to lesser constitutional protection. Moreover, Edenfield confirms that even with commercial speech that proposes a commercial arrangement, the Central Hudson test must be applied.

Ibid. Here, the Court of Appeals summarily rejected any First Amendment defense without applying the Central Hudson test.

This Court should resolve the important issues presented and define the contours of protected parody and "commercial speech."

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